SUPREME COURT, U. S.
DEC 7 1962
JOHN F. DAVIS, CLERK

No. 645

IN THE

Supreme Court of the United States

OCTOBER TERM, 1962

THE BENDIX CORPORATION,
Appellant

v.

RADIO POSITION FINDING CORPORATION,
Appellee.

On Appeal from the United States District Court for the District of Maryland

---

JURISDICTIONAL STATEMENT

EDWARD S. IRONS
HAROLD J. BIRCH

Of Counsel:

IRONS, BIRCH, SWINDLER & MCKIE
One Thousand Connecticut Avenue, N.W.
Washington 6, D. C.
Attorneys for Appellant

December 6, 1962

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

TABLE OF CONTENTS

	Page
Table of Cases	ii
Table of Statutes	iii
Jurisdictional Statement	1
I. Opinion Below	2
II. Jurisdiction	2
III. The Questions Presented	2
IV. The Statute Involved	5
V. Statement of the Case	6
VI. Substantiality of Questions	12
A. The Scope of the Authority Delegated Congress by the Patent Clause—Questions 1 Through 4, 6, and 8	13
B. Substantive and Procedural Due Process	20
1. The Right of the People to Utilize Public Knowledge Is Subject to Due Process Protection—Questions 8 and 11	20
2. The Unfair, Arbitrary, and Capricious Nature of Private Law 1008—Question 9	27
3. Procedural Due Process Violation—Question 10	29
C. May Congress Grant a Patent for Less Than the Exclusive Right in the Invention—Question 5	30
D. Governmental Inequities to a Private Citizen May Be Redressed Only by the Payment of Monies from the Federal Treasury—Question 7	38
Appendix	1a

Page

TABLE OF CASES

Agawam v. *Jordan*, 7 Wall. 583, 74 U.S. 583 (1858) .. 19
Bloomer v. *McQuewan, et al.*, 14 How. 539, 14 L. ed. 532 (1853) 31
Bolling v. *Sharpe*, 347 U.S. 497, 98 L. ed. 884 (1954) .. 30
Campbell v. *Holt*, 115 U.S. 620, 29 L. ed. 483 (1885) .. 25, 26
Carbice Corporation of America v. *American Patents Development Corp.*, 283 U.S. 27, 75 L. ed. 819 (1931) 18
Chase Securities Corp. v. *Donaldson*, 325 U.S. 304, 89 L. ed. 1628 (1945) 25
Cincinnati Soap Co. v. *United States*, 301 U.S. 308, 81 L. ed. 1172 (1932) 40
Dunzer Co. v. *Gulf Railroad*, 268 U.S. 633, 69 L. ed. 1126 (1925) 26, 27
Evans v. *Eaton*, 3 Wheat. 454, 16 U.S. 454 (1818) 19
Evans v. *Jordan*, 9 Cranch. 199, 13 U.S. 199 (1815) ... 19
Fire Extinguisher Case, 21 Fed. 40 (C.C. Md. 1884) ... 19
Florida Lime & Avacado Growers Inc. v. *Jacobsen*, 362 U.S. 73, 4 L. ed. 2d 568 (1960) 2
Galvan v. *Press*, 347 U.S. 522, 98 L. ed. 911 (1954) .. 25, 28, 29, 30
Giozza v. *Tiernan*, 148 U.S. 657, 37 L. ed. 599 (1893) ... 30
Grant, et al. v. *Raymond*, 6 Pet. 218, 8 L. ed. 376 (1832) 17, 31
Great Atlantic & Pacific Tea Co. v. *Supermarket Equipment Corp.*, 340 U.S. 147, 95 L. ed. 162 (1950) .. 17, 18, 19, 32, 36
Hotchkiss v. *Greenwood*, 11 How. 248, 13 L. ed. 683 .. 18
Leitch Manufacturing Co. v. *Barber*, 302 U.S. 458, 82 L. ed. 371 (1938) 18
McClurg v. *Kingsland*, 42 U.S. 202, 11 L. ed. 102 (1843) 36
Mercoid Corporation v. *Midcontinent Investment Co.*, 320 U.S. 661, 88 L. ed. 376 (1944) 18
Morton Salt Company v. *Suppiger*, 314 U.S. 488, 86 L. ed. 363 (1942) 18
Motion Picture Patents Company v. *Universal Film Manufacturing Company*, 243 U.S. 502, 61 L. ed. 871 (1917) 17, 18
Nebbia v. *New York*, 291 U.S. 502, 78 L. ed. 940 (1934) 28, 29, 30
Patton v. *United States*, 75 F. Supp. 470 (C. Cl. 1948) 40

Page

Pennock v. *Dialogue*, 2 Pet. 1, 7 L.ed. 327 (1829) . . 16, 17, 21, 22, 31, 36
Pope v. *United States*, 323 U.S. 1, 89 L. ed. 3 (1944) . . 40
Stainback v. *Mo Hock Ke Lok Po*, 336 U.S. 368, 93 L. ed. 741 (1949) 2
United States v. *Dubilier Condenser Corp.*, 289 U.S. 178, 53 S. Ct. 554, 77 L. ed. 1114 (1933) 17
United States v. *Line Material Co.*, 333 U.S. 287, 92 L. ed. 701 (1948) 15, 32
United States v. *Loew's*, — U.S. — (1962) 18, 29
United States v. *Masonite Corporation*, 316 U.S. 265, 62 S. Ct. 1070, 86 L. ed. 1461 (1942) 17
United States v. *National Lead Company*, 332 U.S. 751, 92 L. ed. 338 (1947) 35
United States v. *Paramount Pictures, Inc.*, 334 U.S. 131, 92 L. ed. 1260 (1948) 29
United States v. *Realty Co.*, 163 U.S. 427, 41 L. ed. 215 (1896) 40
Vicksburg v. *Vicksburg Waterworks Co.*, 202 U.S. 453, 50 L. ed. 1102 (1906) 33, 34
Wright v. *United States*, 302 U.S. 583, 82 L. ed. 439 (1938) 33, 34

TABLE OF STATUTES

Constitution of the United States of America, Article 1, § 8, Cl. 8 . . . . . 13, 26, 39, 40
28 USC § 1253 2
28 USC § 2101(b) 2
28 USC § 2282 . . . . . 2, 5
35 USC 20
35 USC § 37 . . . . . 7, 8
35 USC § 102 . . . . . 2, 3, 4, 5
35 USC § 181 8
35 USC § 252 35
35 USC § 282 22
42 USC § 2013(d) 35
42 USC § 2187(c) 35
RS 4886 . . . . . 8, 9, 25, 29

IN THE

Supreme Court of the United States

OCTOBER TERM, 1962

No.

THE BENDIX CORPORATION,

Appellant

v.

RADIO POSITION FINDING CORPORATION,

Appellee.

On Appeal from the United States District Court for the District of Maryland

JURISDICTIONAL STATEMENT

This is an appeal from an Order of the United States District Court for the District of Maryland denying appellant's motion for permanent injunction against the enforcement of a Federal statute.

I. OPINION BELOW

Appellant's motion was heard by a three-judge court on April 9, 1962, and is reported at 205 F. Supp. 850 (1962).

* Unless otherwise indicated, all emphasis has been supplied.

A copy of the opinion of the three-judge court denying appellant's motion for permanent injunction against the enforcement of Private Law 1008 is appended as Appendix A.

A copy of the Order of July 10, 1962, of the United States District Court for the District of Maryland is appended as Appendix B.

II. JURISDICTION

Appellant's motion for permanent injunction against the enforcement of a Federal statute was brought pursuant to 28 USC § 2282.

The decision denying appellant's motion was filed June 8, 1962, and the final Order was entered July 10, 1962. Notice of appeal was filed on August 9, 1962, in the United States District Court for the District of Maryland.[1]

Jurisdiction of this appeal is conferred on this Court by 28 USC § 1253 and 28 USC § 2101(b). The following decisions sustain the jurisdiction of this Court to review the judgment below on direct appeal: *Stainback* v. *Mo Hock Ke Lok Po*, 336 U. S. 368, 93 L. ed. 741 (1949); *Florida Lime & Avocado Growers Inc.* v. *Jacobsen*, 362 U. S. 73, 4 L. ed. 2d 568 (1960).

III. THE QUESTIONS PRESENTED

1. Can a private law which removes the prohibitions of 35 USC § 102 to permit the grant of a valid patent to a government employee be sustained under the patent clause of the Constitution in the face of an express finding and admission that the disclosure and publication of the patented invention deliberately was sup-

[1] Due to two Orders under Rule 13, the time for docketing this case has been extended to December 8, 1962.

pressed by the government, having regard to the repeated rulings of the Supreme Court that promotion of "the progress of science and useful arts" is defeated by suppression?

2. Can a private law which removes the prohibitions of 35 USC § 102 to permit the grant of a patent to a government employee directed by his superior not to file a patent application for a substantial time period during which the invention passed into the public domain, *inter alia,* by third party disclosures and government press releases, be sustained under the patent clause of the Constitution?

3. Does the constitutional prerequisite that a patent grant be for a "limited time" require the prompt filing of an adequate patent application by the inventor?

4. Can a private law authorizing the grant of a patent be sustained under the patent clause of the Constitution absent an affirmative determination that such law is effective "to promote the progress of science and useful arts?"

5. May Congress, under the constitutional mandate "to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries," validly enact a private bill which does not secure to an alleged inventor the exclusive right to his invention, but instead provides that "except to the extent of requiring a payment of a reasonable fee or royalty," the inventor shall not be entitled to enforce any patent granted thereunder against a specifically identified class of persons?

6. May the Congress validly enact a private law permitting the granting of a patent embracive of an as-

serted invention, the issuance of said patent being otherwise prohibited by 35 USC § 102 at a date prior to the completion of the asserted invention by a patentee?

7. Is the Congress limited in the redress of governmental inequities to private citizens to authorizing the payment to the aggrieved individual of monies from the Federal Treasury?

8. May Congress, to redress an alleged inequity to a government employee, validly enact a private law which removes the prohibitions of 35 USC § 102 to permit the grant of a patent to such employee for an invention, the disclosure and publication of which was deliberately suppressed by the government and which had passed into the public domain prior to such enactment?

9. May Congress, having regard to the Fifth Amendment requirements of substantive and procedural due process, constitutionally enact a private law to correct a government inequity to an individual, which law (a) arbitrarily shifts the burden of reparation from the government to a segment of the public having no responsibility for or connection with such inequity, and (b) requires that such reparation be paid in an indefinite and unspecified amount never established by administrative or judicial due process and without reasonable relation to the damage allegedly suffered?

10. May Congress, having regard to the Fifth Amendment requirements of substantive and procedural due process, constitutionally enact a private law to correct a government inequity to an individual, which law (a) removes the statutory limitation period within which an application for a valid patent could

have been filed, and (b) discriminates against other applicants claiming to have made the same invention but for whom the bar of the limitation statute was not removed whereby such other applicants were precluded from contesting priority of invention on the basis of actual proof of originality?

11. Does the expiration of the limitation period contained in 35 USC § 102, within which an application for a valid patent may be filed having regard to preexisting public knowledge of the invention, create a substantive right in the public such that the statutory limitation period cannot be waived without violation of Fifth Amendment due process?

12. May a private law, authorizing the granting of a patent in derogation of 35 USC § 102, properly be challenged on constitutional grounds before a three-judge court empaneled under 28 USC § 2282?

IV. THE STATUTE INVOLVED

Appellant's motion seeks to enjoin enforcement of Private Law 1008, 81st Congress, 1950, which provides:

> "AN ACT
> "(to correct possible inequity in the case of a certain application for letters patent of William R. Blair)
>
> "BE IT ENACTED BY THE SENATE AND HOUSE OF REPRESENTATIVES OF THE UNITED STATES OF AMERICA IN CONGRESS ASSEMBLED, That notwithstanding any provision of existing law, the application for United States letters patent of William R. Blair, Serial No. 598,167, filed June 7, 1945, for Object Locating System, shall not be rejected nor shall any patent granted on said application be held invalid by reason of the fact that the inven-

tion disclosed in said application was patented or described in a printed publication in this or any foreign country, or was in public use or on sale in this country, unless the effective date of such patent, publication, public use, or sale, is prior to the date of said invention by the said William R. Blair: PROVIDED, HOWEVER, That the holder of any patent granted under this Act shall not, except to the extent of requiring the payment of a reasonable fee or royalty, be entitled to enforce his patent rights thereunder against any person who, before the passage of this Act, was lawfully manufacturing or using the invention covered by such patent, or was bona fide in possession of any rights in a patent or application for patent conflicting with such patent so issued.

"Approved September 27, 1950."

V. STATEMENT OF THE CASE

Patent 2,803,819—"the basic patent dealing with pulse radar" —issued to Colonel William R. Blair on August 20, 1957, from an application filed June 7, 1945. At the time the application was filed, the invention was available for free public use by reason of third party disclosures which precluded the grant of a valid patent to Blair. The patent was issued as a result of a Private Law passed by Congress and withdrew pulse radar from the public domain into the cloak of a private monopoly for the sole benefit of the patentee. The stated purpose of the Congress in so compromising the public right was "to correct a possible inequity" *of the government* to Blair.

The Signal Corps Laboratories, while Blair was Commanding Officer, first assembled a pulse radar sys-

---

Page 6, plaintiff's "Memorandum of Points and Authorities" in the court below.

tem in the spring of 1937. In May of 1937, that system was demonstrated to certain representatives of the Armed Forces and the Congress.

Blair contends that during the course of the May, 1937, demonstration, he verbally sought permission to file an appropriate patent application and that his superior, General Craig, verbally ordered that such application be not filed and that the system be maintained in secrecy. Blair retired early in 1938 and had no further connection with the Signal Corps development of pulse radar.

Not until June 7, 1945, seven years after Blair's retirement, did the Signal Corps elect to file the application which matured into the patent in suit.

Government suppression[2] of the invention allegedly made by Blair, however, terminated at least as early

---

[2] Plaintiff's "Memorandum of Points and Authorities" in the lower court admits at page 11, ". . . Government . . . *suppression* for a time of . . . disclosure and publication . . ." of the Blair invention.

Under the existing law, no excuse for the suppression of the disclosure of the Blair invention to the Patent Office ever existed. General Craig's directive, if made, was in ignorance of 35 USC § 37, then effective, which adequately protected the secrecy of patent applications owned by the government. The statute provided:

". . . No application shall be regarded as abandoned which has become the property of the Government of the United States and with respect to which the head of any department of the Government shall have certified to the Commissioner of Patents, within a period of three years, that the invention disclosed therein is important to the armament or defense of the United States. Within ninety days, and not less than thirty days, before the expiration of any such three-year period the Commissioner of Patents shall, in writing, notify the head of the department interested in any pending application for patent, of the approaching expiration of the three-year period

as 1942, when Signal Corps patent attorneys began to file numerous patent applications claiming specific details of the pulse radar system. Each such application *fully disclosed* the alleged "Blair" invention. At least forty of such applications were filed by the Signal Corps prior to the filing of the Blair application in June of 1945. None of these forty-odd applications was filed in the name of Blair.[4]

Moreover, the "Blair" radar system was fully described in April and July of 1943 in newspaper articles emanating from the United States Government.[5]

The Patent Office in March of 1947, under the provisions of RS,4886, *finally* rejected the generic Blair radar claims.[6]

---

within which any application for patent shall have been pending."

Obviously, therefore, an application embracive of Blair's asserted concepts could have been filed under the provisions of 35 USC § 37 and left dormant in the files of the Patent Office for three years. The three-year periods were extendable merely by renewing a request that the application remain under the provisions of the statute after notice from the Commissioner that the initial three-year period would soon expire. In the instant situation, however, the secrecy of any such application would have been protected adequately by 35 USC § 181, which was enacted before the original three-year period would have expired.

That 35 USC § 37 was deemed an adequate safeguard by the Armed Forces is conclusively demonstrated by the fact that the Navy Department employed that very route to protect precisely the same disclosure of pulse radar in applications filed by inventors at the Naval Research Laboratory *before* enactment of 35 USC § 181.

[4] See defendant's Blair deposition Exhibit 50.

[5] See defendant's Blair deposition Exhibits 47 and 47a.

[6] RS 4886, in effect when the Blair application was filed, required a patent applicant to present his application to the Patent Office within one year of a public disclosure of the alleged invention.

Faced with the denial of his application, Blair sought a private act from Congress to *annul* RS 4886 *as to him alone*. The government, fearful that a basic radar patent might issue to a third party, took up the cudgel for Blair, under whose application it enjoyed license.[1]

Senate Report 1665, 81st Congress, 2d Session (1950), acknowledges that at the time Private Law 1008 was passed,

> "The said William R. Blair *is now barred* from receiving a patent on his invention or of contesting the priority of invention as between others who are claiming the same patentable subject matter *because his invention was described in a publication* having an effective date more than 1 year prior to the filing of the Blair application."

As appears from the certified file history of the Blair application, the publications which vested the pulse

[1] The letter from the Secretary of the Army which accompanied Senate Report 1665 on the Blair bill, contains the following significant paragraph:

> "The matter *has an importance to the United States Government itself*, since the invention was developed in laboratories of the United States Government and, as above stated, *the Government is licensed* under the application and the invention. If, due to present statutory bars, a fundamental patent should improperly issue to adverse claimants and a suit were to be brought thereon against the United States after witnesses having personal knowledge of Colonel Blair's early work have died, as some have already, it would be difficult for the Government to prove the true facts concerning this matter in defending itself against suit in the Court of Claims. *It is one of the main purposes of the proposed bill to save the Government from paying claims for royalties for patents which may be granted because Colonel Blair is presently barred by statute from presenting evidence* of his earlier developments which he at the proper time was directed in the interest of the security of the United States from disclosing."

radar invention in the public and barred Blair from a patent, emanated neither from Blair nor the United States Government, but from third parties."

The Senate Report stated the purpose of Private Law 1008 as follows:

> "This bill would remove the aforementioned statutory bars which now *prevent* the said William R. Blair *from receiving a patent*, or fairly and *equitably contesting priority of invention* in accordance with the provisions of Revised Statutes 4904 as between himself and *other applicants for patent claiming the same patentable subject matter*. . . .
>
> * * * *
>
> "This bill will not assure the granting of a patent to Colonel Blair. This bill is for the purpose of enabling Colonel Blair *to contest priority* in

[2] The certified file history is a Joint Exhibit of the parties and forms a part of the record before this Court. Pages 37 and 67 of the Exhibit reflect that Blair was barred by U. S. patent 2,345,932 to Gould, issued April 4, 1944; U. S. patent 2,231,929 to Lyman, issued February 18, 1941; U. S. patent 2,237,193 to Mobsby, issued April 1, 1941; Australian patent 111,594 issued March 19, 1939; Australian patent 108,556 issued September 14, 1934; British patent 552,072 issued March 22, 1943; and British patent 555,052 issued August 3, 1943.

The pertinent portion of the March 18, 1947, final rejection (page 67 of the file history) reads as follows:

> "It is noted that each of Gould, Lyman, Mobsby, the Australian patents 111,594 and 108,556, and the British patents 552,072 and 555,052 are patents or printed publications more than one year prior to the date on which this application was filed in this country. Each of these references therefore comprises a *statutory bar* against applicant's case for all that they disclose. . . . Therefore, an issue appears to have been reached and this rejection is made FINAL."

On July 17, 1947, the first Blair bill, HR 4260, was introduced in the Congress.

the United States Patent Office as to his invention *with other parties claiming the same invention.* Thus, if Colonel Blair is unsuccessful in proving that he is the prior inventor, no patent will issue to him. *This bill would give no special advantage as to priority or patentability to Colonel Blair,* nor does this bill ask that any determination involving patentability or priority be waived by the Patent Office.

"*The Government has a direct interest in this application* in that it is a licensee under this invention. The invention pertains to radar, one of the most important military weapons known to modern science and which was used for the first time in the last war."

Despite the express intentions of Congress to the contrary, the net effect of Private Law 1008 was to withdraw pulse radar from the public into a private patent monopoly for the sole benefit of Blair!

Private Law 1008 inexorably gave its beneficiary an unconscionable advantage by *leaving* the "other parties claiming the same invention" *subject* to the very disability the Act removed from Blair. The "other parties claiming the same invention" were precluded from "fairly and equitably contesting priority of invention" *by the very statute which the Private Law voided for Blair alone.* This shocking consequence of Private Law 1008, in due course, resulted in the grant of the patent in suit to Blair *without a priority contest* with his disabled opponents—all in square derogation of the pre-existing public right to use the invention.

VI. SUBSTANTIALITY OF QUESTIONS

The decision of the court below holding that Congress, under the guise of redress to an individual for a purported governmental inequity, could withdraw pulse radar from the public domain, is in conflict with this Court's consistent interpretation of the pertinent constitutional and statutory provisions. The grave issues thus raised fall into four categories.*

Questions 1 to 4, 6, and 8 require determination by this Court of the precise scope of authority delegated to the Congress by the patent clause of the Constitution.

Questions 8 to 11 present fundamental issues of substantive and procedural due process which were resolved by the court below in a manner conflicting with the controlling decisions of this Court. Specifically, questions 8 and 11 challenge the ruling of the court below that the right of the people to use the fund of public knowledge is not subject to the protection of due process. Question 9 presents the issue of whether the Congress, consistent with the requirements of due process, may redress a government inequity to an individual by shifting the burden of reparation from the government to an isolated segment of the public having no responsibility for or connection with the inequity. Question 10 presents a basic question of procedural due process implicit in the repeal of the statutory prerequisites to patentability for a single individual, thereby permitting the grant of a patent on the basis of an unfair priority contest with other applicants bound by the statute.

* Question 12 is considered moot and withdrawn

Question 5 raises the basic constitutional issue of whether the patent clause authorizes the Congress to grant a patent for other than the "exclusive right" in an invention.

The fundamental issue of the scope of Congressional authority to enact private bills is raised by question 7, which challenges the ruling of the court below that the Congress may redress a governmental wrong to a private citizen by a means other than the payment of monies from the Federal Treasury.

A. The Scope of the Authority Delegated Congress by the Patent Clause—Questions 1 Through 4, 6, and 8

The court below has held that Congress is empowered by the patent clause of the Constitution [10] to redress government inequity to an individual by a private act authorizing the grant of a patent monopoly on subject matter in the public domain.

The decision is in direct conflict with the decisions of this Court which establish the basic principle that patent monopolies are constitutionally authorized only (a) to promote the *progress* of science and useful arts; (b) in the interest of the public as distinguished from that of private parties; (c) by obtaining the prompt disclosure of inventions to the people.

The gravity of the issue is apparent from a consideration of the constitutional history of the patent clause which demonstrates a determined purpose to *restrict*

[10] Article 1, § 8, Cl. 8, which provides:

"The Congress shall have power * * * to promote the *progress* of science and the useful arts, by securing, for limited times, to authors and inventors the exclusive right to their respective writings and discoveries."

the authority of Congress to legislation authorizing issuance of patents on new inventions. The constitutional objective was to *prevent* the grant of patent monopolies for subject matter in the *public* domain for the purpose of advancing *private* interests in derogation of the *public* right.

The origin and purpose of the patent clause was well stated in HR 1494, 52nd Congress, 1st Session,[11] as follows:

> "We derive our conception of the granting of letters patent, conferring a monopoly of production or use of a machine, or composition of matter, or new and useful improvement therein for a time limited by such letters from Great Britain. The practice had there grown up of conferring patents by the Crown, without the existence of any statute law authorizing their issue. A favorite at court, the needy relative of some powerful man, a lucky schemer, was given the sole right by royal grant to produce certain articles or to furnish certain supplies. *These patents were originally monopolistic grants for the full use or traffic in articles long known* to a very large degree. But few of them were for the sole enjoyment of home need, invention, or discovery.
>
> "The abuse of this power became so great that in 1624, during the reign of James I, Parliament passed the famous statute of 'monopolies,' cutting off the monopolies granted by the King, but *excepting* from the operation of the act 'letters patent and grants of privilege for a term of twenty-one years or under, heretofore made, of the sole working or making of any manner of *new* manu-

[11] Which related to a proposed amendment of the then-existing patent statutes. The pertinent portions of this report are reproduced as Appendix C.

facture, within this realm, to the inventor or inventors of such manufacture.'"[12]

The House Report then delineates the patent practices of the Colonies and states:

> "It will be seen that when the framers of the new Constitution came to deal with this matter they had no new subject in hand. The granting for a limited term to an inventor of some *new* and useful machine the sole right to make, use, and vend such invention was a practice then nearly two centuries old, and one which, in this country, had existed for a century and a half."

It is clear that

> "The Fathers who met at Philadelphia were . . . well acquainted, both from history and by experience, with the excesses which had attended the royal 'patent of monopoly.' They knew the part the fight against the royal prerogative, finding legislative expression in the Statute of Monopolies, had played in the struggle by which 'English liberties' were won and American independence established. *Intent upon preventing* the recurrence of a 'plague of monopolies,' *they conferred upon the new republic*—a government of delegated and limited powers—*no general warrant to issue exclusive writs of any kind.* The mandate is thus to be read as an exception to the general rule." [W. Hamilton and I. Till, "What Is a Patent?" 13 Law & Contemp. Prob. 245, 246 (1948)]

Thus the Constitution authorizes patents *only* in the public interest. The advancement of private interests

[12] The facts summarized in the foregoing quotation are matters of historical record. See, *inter alia*, Robinson On Patents (1890); Curtis Law of Patents (1873); in *U. S. v. Line Material Co.*, 333 U. S. 287, 92 Led. 701, 728 (1948), the dissenting opinion.

—even of the inventor—is wholly secondary.[13] *Abridgement* of the public right by the grant of a patent monopoly on known manufactures is *prohibited.*

These principles, axiomatic in the then contemporary English law, were recognized in *Pennock* v. *Dialogue*, 2 Pet. 1, 7 L.ed. 327 (1829), the first patent case decided by this Court, as follows:

> "We think, then, the true meaning must be, not known or used by the public before the application. And, thus construed, there is much reason for the limitation thus imposed by the Act. While one great object was, by holding out a reasonable reward to inventors, and giving them an exclusive right to their inventions for a limited period, to stimulate the efforts of genius; the *main object* was 'to promote the *progress* of science and useful arts;' and *this* could be done best by giving the public at large a right to make, construct, use, and vend the thing invented, at as early a period as possible; having a due regard to the rights of the inventor.
>
> * * * *
>
> ". . . *In respect to the case of a second invention, it is questionable at least, whether, if by such second invention a public use was already acquired, it could be deemed a case within the protection of the Act. If the public were already in possession and common use of an invention fairly and without fraud*, there might be sound reason for presuming, that the Legislature did not intend to grant an exclusive right to anyone to monopolize that which was already common. *There would be no quid pro*

[13] As stated in HR 1494, *supra*,

> "It is sufficient to read the words of the grant in their plain everyday meaning to discover that the good of society was the only thing provided for or intended to be provided for."

quo, no price for the exclusive right or monopoly conferred upon the inventor for fourteen years."[11]

Pennock v. *Dialogue* has repeatedly been cited by this Court in emphasizing the foregoing principles. See *Motion Picture Patents Company* v. *Universal Film Manufacturing Company*, 243 U. S. 502, 61 L.ed. 871 (1917); *United States* v. *Masonite Corporation*, 316 U. S. 265, 62 S. Ct. 1070, 86 L.ed. 1461 (1942); *United States* v. *Dubilier Condenser Corp.*, 289 U. S. 178, 186, 187, 53 S. Ct. 554, 77 L.ed. 1114, 1118 (1933).

In *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, 95 L.ed. 162 (1950), this Court, in overruling the decision of both lower courts sustaining the validity of the patent, held:

> ". . . The function of a patent *is to add* to the sum of useful knowledge. *Patents cannot be sustained, when on the contrary, their effect is to subtract from former resources freely available to skilled artisans.* A patent for a combination which only unites old elements with no change in their respective functions, such as is presented here, obviously *withdraws what already is known* into the field of its monopoly and diminishes the resources

[11] The failure of constitutional consideration for the patent contract consequent from public knowledge of the alleged invention was again emphasized in *Grant, et al.* v. *Raymond*, 6 Pet. 218, 8 L.ed. 376 (1832), as follows:

> "*It has been urged that the public was put into possession of the machine by the open sale and use of it under the defective specification, and cannot be deprived of it by the grant of a new patent.* The machine is no longer the subject of a patent.
>
> "*This would be perfectly true if the second patent could be considered as independent of the first.*"

> available to skillful men. This patentee has added nothing to the total stock of knowledge . . ." (340 U. S. 152-3, 95 L.ed. 167)

Private Law 1908 on its face is an obvious reversion of the practice, condemned since the passage of the Statute of Monopolies in 1623, of awarding a monopoly on well-known subject matter to an individual as a matter of sovereign favor. Indeed, the *stated purpose* of the *private* act was to "correct a possible inequity" to Blair, a *private* citizen—*not* to advance the *public* interest by promoting "the *progress* of science and the useful arts"—the only justification for a patent cognizable by the Constitution. These elementary prin-

Moreover, the invention for which the patent is granted must be obvious from the pre-existing fund of public knowledge, the contribution being otherwise ineffective "to promote science and the useful arts." *Hotchkiss v. Greenwood*, 11 How. 248, 13 L.ed. 683; *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 95 L.ed. 162.

So also, contracts in the nature of license agreements or otherwise which attempt to employ patents as a means to bring unpatented materials within the scope of the legitimate monopoly are found to render the patents involved unenforceable in a court of equity on the premise that the patent power has been "misused." *Motion Picture Patents Company v. Universal Film Manufacturing Company, et al.*, 243 U. S. 502, 61 L.ed. 871 (1917); *Carbice Corporation of America v. American Patents Development Corp.*, 283 U. S. 27, 75 L.ed. 819 (1931); *Leitch Manufacturing Co. v. Barber*, 302 U. S. 458, 82 L.ed. 371 (1938); *Morton Salt Company v. Suppiger*, 314 U. S. 488, 86 L.ed. 363 (1942); *Mercoid Corporation v. Mid-Continent Investment Co.*, 320 U. S. 661, 88 L.ed. 376 (1944).

In *United States v. Loew's* —— U. S. ——, decided November 5, 1962, this Court, citing the foregoing cases, held:

> "These cases reflect a hostility to use of the statutorily granted patent monopoly to extend the patentee's economic control to unpatented products. The patentee is protected as to his invention, but may not use his patent rights to exact tribute for other articles."

ciples, fully briefed and argued before the court below, were perforce *ignored* in its decision sustaining *Private* Law 1008, which resulted in the grant to Blair of a patent depriving the public of its pre-existing free right to use pulse radar.

The situation is aggravated by the circumstance that the court below purported to find support for its position in several old decisions of this Court [16] as construed in a single District Court case.[17] Significantly, *in each of such cases*, the *public had received the initial*

---

[16] *Evans* v. *Jordan*, 9 Cranch. 199, 13 U. S. 199 (1815); *Evans* v. *Eaton*, 3 Wheat. 454, 16 U. S. 454 (1818); *Agawam* v. *Jordan*, 7 Wall. 583, 74 U. S. 583 (1858).

[17] The *Fire Extinguisher Case*, 21 Fed. 40 (C. C. Md., 1884), in which the Court stated:

> "... In Blanchard v. Sprague, 2 Story 170, Mr. Justice Story, speaking on the right of Congress to grant a patent to an inventor whose invention had, at the time of the passage of the act, gone into public use, says that the question is set at rest by Evans v. Eaton, and that he had never doubted the constitutional authority of Congress to make such a grant.
>
> "The right which the public has acquired to use the thing invented, by reason of the application for a patent failing to do something prescribed *by Congress the necessity for which might, by previous legislation, have dispensed with*, has never been held to be a vested right. The cases of Evans v. Eaton, supra; Evans v. Jordan, 9 Cranch. 199; Bloomer v. Stolley, 5 McLean, 161; Jordan v. Dobson, 2 Abb. (U. S.) 408, hardly leave this question debatable."

There is, of course, no power in Congress to "dispense with" the constitutional requirement expressed in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, *supra*, that patents must "add to the sum of useful knowledge" and "cannot be sustained, when on the contrary, their effect is to subtract from resources freely available to skilled artisans." Hence the *Fire Extinguisher Case* is no justification for Private Law 1008, which withdrew pulse radar from the public domain.

disclosure by the patentee of a new invention which was the quid pro quo for the patent grant.

Moreover, the apparent success of Private Law 1008 has resulted in the introduction of a plurality of bills before the Congress which present precisely the same issue.[*]

To the end that the Congress and the lower courts may be informed concerning the true scope of the patent power, this appeal should be given plenary consideration and heard on its merits.

B. Substantive and Procedural Due Process

1. The Right of the People to Utilize Public Knowledge Is Subject to Due Process Protection—Questions 8 and 11

To sustain the constitutionality of Private Law 1008, the court below ruled, in *conflict* with *apposite* Supreme Court precedent, that the right of a citizen to utilize public knowledge is not property subject to pro-

[*] S 1150, HR 3429 and HR 5451 all were introduced in the 87th Congress, 1st Session, "to correct possible inequity in the case of a certain application for letters patent to Charles H. Denny." As in Private Law 1008, these bills all would remove statutory bar references against the Denny application which arose before such application was filed and which presently preclude issuance of a valid patent. These bills all provide that any patent issuing to Denny shall not be enforceable against certain persons "except to the extent of requiring the payment of a reasonable royalty." HR 459, also introduced during the 87th Congress, 1st Session, proposes to amend 35 USC to again provide for extension of terms of patents. The bill provides that extension may be ordered "notwithstanding that the term of the patent has previously expired." The bill further provides that the extended patent shall not serve as basis for any claim by reason of manufacture, use, or sale by or for the United States or impair the rights of those practicing the invention before passage of the Act except to require payment of a reasonable royalty subsequent to the date of extension.

tection by the due process clause of the Fifth Amendment. To justify its decision, the three-judge tribunal was compelled erroneously to equate the statutory conditions for patentability with procedural statutes of limitation which apply to a remedy only. In so doing, the court construed the pertinent patent statutes in a manner inconsistent with the history and purpose of the legislation as interpreted by this Court.

The fundamental issues thus raised are presented by questions 8 and 11.

Pursuant to the constitutional mandate that the substantive and paramount right of the people to utilize public knowledge be preserved, Congress has enacted a series of statutes definitive of *conditions precedent* which must be satisfied by the patent *applicant*. Among these conditions is the requirement that an adequate application be timely *filed subsequent to public disclosure* of the invention if a valid patent is to be obtained.

This Court, in *Pennock* v. *Dialogue*, *supra*, in construing the first such legislative provision, stated:

> ". . . The Patent Act of 21st of February, 1793, ch. 11, prescribes the *terms* and *conditions* and manner of obtaining patents for inventions; and proof of a *strict compliance with them lies at the foundation of the title acquired by the patentee*." (2 Pet. 17, 7 Led. 333)

Later in the opinion, the Court observed:

> ". . . His voluntary act or acquiescence in the public sale and use is an *abandonment of his right*; or rather, *creates a disability to comply with the terms and conditions* on which alone the Secretary of State is authorized to grant him a patent." (2 Pet. 24, 7 Led. 335)

The Court in *Pennock* recognized that the public is *seized* of an invention *by* its *publication*—not by the failure of the applicant to comply with the substantive statutory conditions precedent to a valid patent grant.[1] It is thus clear that such laws are *not* mere procedural *statutes of limitation, but for which* the public would have *no right* in the publicized invention. Rather, but for the statutory grace period, the inventor has *no right* to a patent for an invention known to the public prior to his application.

These basic precepts have been incorporated into every patent statute since the first act in 1790. The current statute provides:

> "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvements thereof, may obtain a patent therefor, subject to the *conditions* and *requirements* of this title. July 19, 1952, c. 950, § 1, 66 Stat. 797."

Similarly, 35 USC § 282, which specifies the defenses available in any action involving the validity of a patent, provides:

> "The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:
>
> * * * * *
>
> "(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a *condition for patentability*,
>
> "(3) Invalidity of the patent or any claim in suit for failure to comply *with any re-*

[1] "A conclusion compelled by the constitutional history of the patent clause which was expressly framed to foreclose the grant of monopolies on subject matter in the public domain.

> *quirement* of sections 112 or 251 of this title . . ."

To sustain the validity of the Private Law, the court below equated the conditions precedent to a valid patent defined by RS 4886 to a mere statute of limitation operating against Blair, and hence misconstrued the *relationship* of the patent grant to the *right of the public to utilize information within its domain.* The court below held:

> ". . . : defendant is in error when it argues that it and the *public acquired* a property right in the Blair invention by reason of Blair's failure to pursue a timely application for a patent, and that this right is one entitled to the protection of the due process clause.
>
> "Private Act 1008 did nothing more than waive the statute of limitations.
>
> "In Federal jurisprudence, statutes of limitation are not generally considered to create vested rights in those whose obligations are barred from enforcement . . .
>
> "We think defendant and the *public acquired* no property right, of which they have been deprived."

The error of the court below is thus apparent from the face of its ruling. The public was under no "obligation" to Blair which was "barred from enforcement by RS 4886." The public right to use the Blair invention was "acquired" by reason of its *publication prior* to the Blair *application*—not as a result of "Blair's failure to pursue a timely application for a patent." *Because* of his laches, Blair *lost* his right to acquire a valid patent, and the *pre-existing* public right was *preserved.* In an effort to sustain Private Law 1008, the

court below has compromised the public right by a distorted construction of the very statutes enacted for its protection.[20]

Indeed, Congress *itself* recognized the manifest unfairness of its action and amended the original Blair bill to partially protect the rights of those who initiated the manufacture of pulse radar prior to the enactment of Private Law 1008.[21] But the unfairness of the Blair

[20] The treatment afforded the patent statutes by the court below is reminiscent of the story told by Baron Munchausen in the early thirties: While sleighing across the Russian Steppes, the Baron was pursued by a huge and voracious timber wolf. Just as the wolf was about to devour him, the Baron states that he reached into the animal's gaping jaws, grabbed the wolf by the tail, and pulled him inside out; whereupon the wolf raced off in the opposite direction. So the court below has turned the patent statutes upon themselves to defeat the public right.

[21] Senate Report 1665 relating to the Blair bill, with respect to such amendment, states:

> "During the hearings the question arose concerning the present and future rights of parties now manufacturing, selling, etc., the device which Colonel Blair claims he invented and which will be the subject matter of interference proceedings. The danger was feared that Colonel Blair, after enactment of the proposed legislation, might possibly be the victor in the interference proceedings and emerge with a basic patent, and that under existing law he could prohibit the manufacture of the invention or its sale or use, or he had the option of driving an *unconscionable royalty bargain*. The Standing Subcommittee on Patents, Trademarks and Copyrights believe, that, as to innocent persons who are presently manufacturing said invention, *it is manifestly unfair* to deny them the right to continue to so manufacture, since it is possible they went into said manufacture expending large sums for capital investment *relying on the fact that Colonel Blair was barred by the cited prohibition statutes*. The same conclusion is considered true in connection with the persons who may have obtained

bill and the consequent violation of due process[22] was not vitiated by a proviso which "simply protects the rights of intervening parties . . ." The *public at large* enjoyed the *free* right to use the Blair invention, and the *public at large*, including defendant, were unfairly deprived of that right in violation of due process by Public Law 1008.

It is thus clear that the lower court's reliance upon *Campbell v. Holt*, 115 U. S. 620, 29 L.ed. 483, (1885), and *Chase Securities Corp. v. Donaldson*, 325 U. S. 304, 89 L.ed. 1628, (1945), was not well founded. As the court recognized, the rule of such cases is to the effect that the restoration of a mere remedy by the repeal of a statute of limitations is not violative of due process.

---

patents or filed applications for patents, which would be dominated by any patent granted to Colonel Blair.

"For the foregoing reasons, the subcommittee inserted a proviso stating to the effect that any patent granted under this act shall not impair the right of such persons, but any such persons shall have the right to make, use, and vend the invention during the term of the patent, subject to the payment of a *reasonable charge or royalty*.

"Thus, to summarize and conclude, the subject proviso amendment in effect simply protects the rights of intervening parties and thereby accomplishes a more equitable solution of the party's difficulties."

[22] "Due process bars Congress from enactments that shock the sense of fair play which is the essence of due process." *Galvan v. Press*, 347 U. S. 522, 530, 98 L.ed. 911, 921 (1954).

Chase Securities is inapposite on the face of the quotation in the lower court opinion which refers to such limitation statutes as matters of "legislative grace . . . subject to a relatively large degree of legislative control." The preservation of the public right is not a matter of legislative grace, and it is not within the control of Congress to vitiate the requirement of timely disclosure as a *quid pro quo* for a constitutionally valid patent.

The decision here controlling and speciously distinguished by the lower court is *William Danzer Co. v. Gulf Railroad*, 268 U. S. 633, 69 L.ed. 1126, (1925). In the *Danzer* case, this Court has held that the rule of *Campbell v. Holt* does not apply where the *same statute*

(a) creates a cause of action, and

(b) *as part of the definition* of that cause of action provides "a time period within which" the beneficiary of the statute must act.

In distinguishing *Campbell v. Holt*, the Court in *Danzer* stated:

". . . That case belonged to the class where statutory provisions fixing the time within which suits must be brought to enforce an existing cause of action are held to apply to the remedy only. *But such provisions sometimes constitute a part of the definition of a cause of action created by the same or another provision, and operate as a limitation upon liability.* Such, for example, are statutory causes of action for death by wrongful act . . . (citing authorities) . . . and those arising under the Federal Employers' Liability Act . . . (citing authorities) . . . This case belongs to the latter class. Section 206(f) will not be construed retroactively to create liability. *To give it that effect would be to deprive defendant of its property without due process of law, in contravention of the 5th Amendment.*"

The patent statutes, under the mandate of Article 1, Section 8, Clause 8 of the Constitution, create a "cause of action" in an inventor to obtain a patent. As part of the definition of such cause of action, however, the patent statutes fix "a time period within which" a proper application must be filed.

The statutory right of the inventor (and conversely the liability of the public under a patent issuing on a *timely* filed application) *is* "inextricably mixed" with statutory prerequisites "which operate *as a limitation*" on both. To reduce the terms and conditions of the patent statutes which define the prerequisites of both patentability *and* validity to the status of mere statutes of limitation

> "would be to deprive defendant (and the public) of its property without due process of law, in contravention of the 5th Amendment"——

and in contravention of the controlling decision of this Court in the *Danzer* case.[24]

2. The Unfair, Arbitrary, and Capricious Nature of Private Law 1008—Question 9

Question 9 presents the conflict between the decision of the lower court sustaining Private Law 1008 and the decisions of this Court which recognize that

[24] In *Danzer*, the Court pointed to the statutory cause of action for death by wrongful act as an example of statutory provisions containing conditions precedent constituting "part of the definition of the cause of action created." It is significant that in such causes of action, it is required that a claimant affirmatively plead that his action has been brought within the time specified by the statute. Similarly, in compliance with the statutory condition precedent to the claimant of a patent, the patent applicant must file with his application an oath certifying that he is the first inventor, and that his invention has not been described in a printed publication or been in public use or on sale for more than one year prior to the date of his application. This strikingly similar requirement of the law clearly indicates that the *Danzer* rule is squarely applicable to this case and is dispositive of the due process issued raised by Private Law 1008.

> "Due process bars Congress from enactments that shock the sense of fair play—which is the essence of due process . . ." [25]

and that the guarantee of due process demands

> ". . . that the law shall not be unreasonable, arbitrary or capricious, and that the means selected shall have a real and substantial relation to the object to be attained." [26]

The stated object of Private Law 1008 was "to correct possible inequity" done by the government to Colonel Blair. To redress such inequity, Congress arbitrarily shifted the burden of reparation from the government to a segment of the public having no responsibility therefor or connection therewith. The means adopted by the Congress to pay the government debt was the issuance of a patent which unfairly permitted Blair to extract a toll from the radar industry. The reparation thus realized by Blair was paid in an indefinite and unspecified amount, never established by due administrative or judicial procedure, and without direct relation to the damage allegedly suffered.[27] Legis-

[25] *Galvan* v. *Press*, 347 U. S. 522, 530, 98 L.ed. 911, 921 (1954).

[26] *Nebbia* v. *New York*, 291 U. S. 502, 525, 78 L.ed. 940, 950 (1934).

[27] Nor was the compensation to Blair in any way commensurate with that to which he might have been entitled had a timely patent application been filed. If Blair had filed a proper application in 1936 when his statutory disability first arose or even within two years of the alleged 1937 radar demonstration at the Signal Corps, any patent issuing in the normal course would have expired or be substantially at the end of its term. Assuming validity, such patent would have covered the usual period of commercial development and exploitation. As a result of Private Law 1008, the term of the patent has been advanced to dominate the later period of commercial development by others and enabled Blair to reap a reward

lation more squarely in derogation of due process as defined in *Galvan* and *Nebbia* would be hard to imagine.

3. Procedural Due Process Violation—Question 10

Private Law 1008 repealed RS 4886 as to Blair alone. In subsequent interference proceedings in the Patent Office, Blair enjoyed an unfair advantage over other applicants with respect to whom the statute remained in effect. As a result, Blair obtained patent 2,803,819 *without even introducing his proofs of priority.*[28]

The violation of the fair play concept of due process is obvious. The decision below is thus in conflict not

---

clearly disproportionate to his contribution. The increase in royalty obligation consequent from Private Law 1008 is at the expense of the innocent bystander who had no responsibility for the governmental error which occasioned the asserted inequity.

See the holding in *United States* v. *Paramount Pictures, Inc.*, 334 U. S. 131, 156-9, 92 L.ed. 1260, 1291-4, quoted verbatim in *United States* v. *Loew's Inc.*, —— U. S. —— (1962), with respect to the required relationship between the reward to the author and the quality of the copyright contribution, as follows:

> "The copyright law, like the patent statutes, makes reward to the owner a secondary consideration. In Fox Film Corp. v. Doyal, 286 U. S. 123, 127, Chief Justice Hughes spoke as follows respecting the copyright monopoly granted by Congress. 'The sole interest of the United States and the primary object in conferring the monopoly lie in the general benefits derived by the public from the labors of authors.' It is said that reward to the author or artists serves to induce release to the public of the products of his creative genius. *But the reward does not serve its public purpose if it is not related to the quality of the copyright . . .*"

[28] As indicated in the fact statement, the interference with Gloess was dismissed on the ground that Gloess was barred from receiving a patent by RS 4886, *the very act repealed as to Blair*, on the basis of references which, but for Private Law 1008, would have been equally effective as to the Blair application.

only with *Galvan* v. *Press* and *Nebbia* v. *New York*, *supra*, but also with *Bolling* v. *Sharpe*, 347 U. S. 497, 499, 98 Led. 884, 886 (1954), where the Court stated:

> "The Fifth Amendment which is applicable in the District of Columbia, does not contain an equal protection clause as does the Fourteenth Amendment which applies only to the states. *But the concepts of equal protection and due process, both stemming from our American ideal of fairness, are not mutually exclusive.* The 'equal protection of the laws' is a more explicit safeguard of prohibited unfairness than 'due process of law,' and, therefore, we do not imply that the two are always interchangeable phrases. But, as this Court has recognized, *discrimination may be so unjustifiable as to be violative of due process.*"

The decision below also conflicts with the doctrine of *Giozza* v. *Tiernan*, 148 U. S. 657, 662, 37 Led. 599, 691 (1893), in which the Court stated:

> "... and due process of law within the meaning of the amendment is secured if the laws operate on all alike, and do not subject the individual to an arbitrary exercise of the powers of government. Leeper v. Texas, 139 U. S. 462 [35:225]."

Question 10 raises the substantial issues of procedural due process thus presented by the decision below.

C. May Congress Grant a Patent for Other Than the Exclusive Right in the Invention—Question 5

Congress, in its deliberations concerning Private Law 1008, recognized that it would be "manifestly unfair" to grant Blair the "exclusive right" in his invention as required by the Constitution.[29] Accord-

[29] See Senate Report 1665, 81st Congress, 2d Session, reproduced as Appendix D, and footnote 21, *supra*, in which the pertinent portion of the Report is reproduced.

ingly, the Congress directed the Patent Office to grant Blair a different right, permitting certain classes of persons to practice the invention.[30] In so doing, the Congress acted in deliberate and premediated derogation of the express terms of the patent clause of the Constitution, which authorizes the grant only of "the exclusive right."

"The decision of the lower court sustaining the constitutionality of Private Law 1008 is thus in direct conflict with the very language of the Constitution itself and with every apposite decision of this Court. In *Pennock v. Dialogue*, *supra*, this Court recognized that one object of the patent laws was

> "by holding out a reasonable reward to inventors, and giving them an *exclusive right* to their inventions for a limited time; to stimulate the efforts of genius . . ."

In *Grant v. Raymond*, *supra*, this Court stated:

> ". . . It cannot be doubted that the settled purpose of the United States has ever been and continues to be to confer on the authors of useful inventions an *exclusive right* in their inventions . . ."

In *Bloomer v. McQuewan, et al.*, 14 How. 539, 549, 14 L.ed. 532, 537 (1853), the Court stated:

> ". . . The franchise which the patent grants, consists *altogether* in the *right to exclude everyone*

[30] The pertinent portion of Private Law 1008 states:

> "Provided, however, that the holder of any patent granted under this Act shall not, except to the extent of requiring the payment of a reasonable fee or royalty, be entitled to enforce his patent rights thereunder against any person who, before the passage of this Act, was lawfully manufacturing or using the invention covered by such patent, or was bona fide in possession of any rights in a patent or application for patent conflicting with such patent so issued."

from making, using, or vending the thing patented, without the permission of the patentee."

More recently, in the concurring opinion in *United States v. Line Material Co.*, 333 U. S. 287, 316, 92 L.ed. 701, 722 (1948), the Court said:

"The Constitution grants Congress the power 'To promote the progress of science and useful arts, by securing for limited times to authors and inventors the *exclusive right* to their respective writings and discoveries.' Art. I, § 8, cl. 8. It is to be noted first that *all* that is secured to inventors is 'the *exclusive right*' to their inventions: . . .

"Congress, *faithful to that standard*, has granted patentees *only* the '*exclusive right* to make, use, and vend the invention or discovery.' Rev Stat § 4884, 35 USCA § 40, 9 FCA title 35, § 40. And as early as 1853 the Court, speaking through Chief Justice Taney, defined the narrow and limited monopoly granted under the statutes as follows: 'The franchise which the patent grants *consists altogether* in the *right to exclude everyone* from making, using, or vending the thing patented, without the permission of the patentee.' Bloomer v. McQuewan, 14 How (US) 539, 549, 14 L.ed 532, 537."

In the concurring opinion of Mr. Justice Douglas in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 151, 95 L.ed. 162, 168 (1950), it is stated:

". . . Article I, § 8 contains a grant to the Congress of the power *to permit* patents to be issued. But unlike most of the specific powers which Congress is given *that grant is qualified*. . . . The purpose is 'To Promote the Progress of Science and useful Arts.' The means for achievement of that end is the *grant* for a limited time to inventors *of the exclusive right* to their inventions."

This Court, in its repeated recognition that *only* the grant of the *exclusive* right is authorized by the Constitution, has, of course, followed the principle *disregarded by the court below* which requires each word of the Constitution be given its natural meaning in the context of the instrument.

The rule is stated in *Wright v. United States*, 302 U. S. 583, 588, 82 L.ed. 439, 442 (1938), as follows:

> "*To disregard such a deliberate choice of words and their natural meaning would be a departure from the first principle of constitutional interpretation.* 'In expounding the Constitution of the United States,' said Chief Justice Taney in Holmes v. Jennison, 14 Pet. 540, 570, 571, 10 L.ed. 579, 594, 595, '*every word must have its due force, and appropriate meaning;* for it is evident from the whole instrument, that no word was unnecessarily used, or needlessly added. The many discussions which have taken place upon the construction of the Constitution, have proved the correctness of this proposition; and shown the high talent, the caution, and the foresight of the illustrious men who framed it. Every word appears to have been weighed with the utmost deliberation, and its force and effect to have been fully understood."

This Court has recognized that the expression, "exclusive right," necessarily means "a sole and undivided privilege." Thus, in *Vicksburg v. Vicksburg Waterworks Co.*, 202 U. S. 453, 471, 50 L.ed. 1102, 1112 (1906), the Supreme Court had occasion to construe a contract pursuant to which the City of Vicksburg granted the waterworks company "the exclusive right and privilege . . . for the period of 30 years" to erect and maintain a waterworks system. With respect to

the word, "exclusive," in the contract in question, the Court stated:

> "The term 'exclusive' *is so plain that little additional light can be gained by resort to the lexicons.* If we turn to the Century dictionary we find it defined to mean 'Appertaining to the subject alone: *not including, admitting, or pertaining to any other or others; undivided; sole; as, an exclusive right or privilege;* exclusive jurisdiction.' We think, therefore, it requires no resort to implication or intendment in order to give a construction to this phase of the contract; but, on the other hand, the city has provided and the company has accepted a grant which says in plain and apt words that it shall have an exclusive right, *a sole and undivided privilege.* To hold otherwise, in our view, would do violence to the plain words of the contract, and permit one of the contracting parties to destroy and defeat the enjoyment of a right which has been granted in plain and unmistakable terms."

The court below, in deliberate derogation of the rule of the *Wright* and *Vicksburg* cases fully briefed and argued below, *has* violated "the first principle of constitutional interpretation" and *has* disregarded "a deliberate choice of words and their natural meaning." In the face of this Court's unequivocal holding that the meaning of "the term, 'exclusive,' is so plain that little additional light can be gained by resort to the lexicons," the court below has held that the "exclusive right" contemplated by the patent clause of the Constitution is *other* than "a sole and undivided privilege." Choosing to ignore the controlling rulings of this Court, in its opinion the three-judge tribunal sustained Pri-

vate Law 1008 on the specious basis of a non-existing "long-standing judicial recognition of flexibility in the exclusive concept of patents."[31]

The important constitutional question raised is not limited to Private Law 1008. Indeed, the question of the power of Congress to grant a patentee other than the exclusive right to his invention has plagued the Congress for at least fifty years.[32]

At least one private bill in substance identical with Private Law 1008 is now pending before the Congress.[33] Various provisions of the Atomic Energy Act[34] entail compulsory licensing, and thus subject all patents in this area of technology to a compromise of the exclusive

---

[31] The fact is that no known decision in any court has *ever* considered the question here presented of whether the Congress may constitutionally authorize the grant of *other* than the exclusive right under the patent clause of the Constitution. *United States v. National Lead Company*, 332 U.S. 751, 92 L.ed. 338 (1947), cited by the lower court in which compulsory licensing of issued patents was decreed in amelioration of an antitrust violation, is irrelevant on its face. 35 U.S.C. § 252, quoted in the court's opinion and relating to the reissue of defective patents, is equally inapposite and moreover is a *new* statute first enacted in 1954 which has never been constitutionally challenged.

[32] The issue was perhaps first raised before the Congress at the hearings before the Congressional Committee on Patents in 1942 on the Oldfield Revision and Codification of the patent statutes, which contained a compulsory licensing proposal.

[33] See footnote 18, *supra*, page 20.

[34] 68 Stat. 947, 42 U.S.C.A. § 2187 (c) and § 2013 (d). As far as is known, the power to grant compulsory licenses never has been exercised by the Atomic Energy Commission pursuant to this Act.

right guaranteed by the Constitution.[*] The Kefauver Drug Industry Antitrust Act,[**] shelved during the 87th Congress, 2d Session (1962), also became a storm center in the patent field because of the constitutionality issue raised by certain proposed provisions requiring the compulsory licensing of patents in the pharmaceutical field.

This appeal should be granted to the end that the power of Congress in this field—a subject of debate for

[*] Those who urge that patents which provide for compulsory licensing may constitutionally be granted invariably attempt to bedstraw the Supreme Court's statement in *McClurg v. Kingsland*, 42 U. S. 202, 11 L. ed. 102 (1843), into support for their position. The Court, in a general discussion precedent to a decision that an infringer-defendant enjoyed an implied license, stated:

> "The powers of Congress to legislate upon the subject of patents is plenary by the terms of the Constitution and as there are no restraints on its exercise, there can be no limitation on the right to modify them at their pleasure, so that they do not take away the rights of property in existing patents."

Significantly, the Court in *McClurg* cites and relies on the decision in *Pennock v. Dialogue, supra*. It is deemed apparent that in the above quotation the Court was stating the truism that the power of Congress to legislate in patent matters is plenary *within* the terms of the Constitution. Clearly, this Court has never ruled that Congress has plenary power in abrogation of *any* constitutional mandate. That this Court in fact has recognized the patent clause of the Constitution imposes limitations on the power of Congress is apparent from the statement in the concurring opinion of Mr. Justice Douglas in *Great Atlantic & Pacific Tea Co. v. Super Market Corp.*, 340 U. S. 147, 154, 95 L. ed. 162, 168 (1950):

> "[Article I, § 8 contains a grant to the Congress of the power to permit patents to be issued. But unlike most of the specific powers which Congress is given *that grant is qualified*."

The Douglas interpretation of the constitutional mandate is in complete accord with the consistent holdings of this Court in patent cases.

[**] S 1552. A companion bill, HR 6245, simultaneously was introduced in the House of Representatives.

half a century—may be defined by this Court.[37] Question 5 is unquestionably substantial.

[37] This dispute over granting patents securing other than the "exclusive right" is clearly pointed up by the following portions of the Congressional Record relating to consideration of the Atomic Energy Act.

Senator Hickenlooper stated:

"... [The] language [of the Constitution] raises a very serious doubt as to the ability of the Congress to confer any rights on inventors except exclusive rights. Compulsory licensing is clearly the granting of a non-exclusive right, and I might add for the period of time during which it may be in effect. Enactment of the compulsory licensing provisions would inevitably lead to judicial interpretation, and there is a very strong possibility that the provisions would be found to be invalid." (100 Cong. Rec. 13645, Aug. 13, 1954)

Representative Meader said:

"Far-reaching changes in patent policy such as this, the constitutionality of which is very doubtful, should properly be considered by the great Committee on the Judiciary." (100 Cong. Rec. A5347, July 24, 1954)

The Chairman of the patent subcommittee, Representative Keating, stated:

"I want to reiterate the gentleman's remarks regarding the unconstitutionality of this provision [Section 153]. I am supporting the amendment offered by the gentleman from New York [Mr. Cole], to a large degree because of my great fear that the existing language would be in violation of the Constitution." (100 Cong. Rec. A5347, July 24, 1954)

Similarly, Representative Walter said:

"I am as sure that the bill as written is unconstitutional as I have ever been about that question in any legislation." (100 Cong. Rec. A5348, July 24, 1954)

Representative Graham stated:

"... I may say that I am as firmly convinced as I am talking to you at this point that the language of the bill is unconstitutional. And you cannot compromise with the question of constitutionality." (100 Cong. Rec. A5346, July 24, 1954)

D. Governmental Inequities to a Private Citizen May Be Redressed Only by the Payment of Monies from the Federal Treasury—Question 7

Congress lacking authority under the patent clause to enact Private Law 1008, the question remains whether the legislation can be justified under any other provision of the Constitution. The substantial and fundamental issue of the scope of the Congressional power to enact private legislation is thus raised for consideration by this Court. The substantiality of the question is manifest from the circumstance that private legislation is a major concern of the Congress. The 87th Congress enacted 684 private and 885 public bills. This Court, however, has never delineated the scope of authority delegated by the Constitution to the Congress in this important field.

The authority to make grants to private individuals and to enact special or private legislation has long been considered in English law as an inherent power of the sovereign derivative from the historical privilege of the citizen to petition his government for redress of grievances.[3] However, it is a basic concept of the con-

[3] The authoritative treatise, "Historical Development of Private Bill Procedure and Standing Orders in the House of Commons," published in 1948 by C. K. Williams, states at page 23:

"As is well known, all parliamentary legislation in this country has developed from petitions to the King, then to the King in Council, then to the King in Parliament, for the redress of grievances, whether national or individual."

As Redlich "The Procedure of the House of Commons" says:

"From the end of the fourteenth century many individuals and corporations began, in their endeavor to obtain special rights from the highest power, that of legislation, to apply to Parliament, or from the time of Henry IV, to the House of Commons alone. We see, then, that petitions ad

stitutional law of *this* country that the government of the United States is one of *delegated* powers. *All* prerogatives of the sovereign *not* delegated to the Federal Government by the Constitution *are reserved* by the Tenth Amendment to the States or the people. Accordingly, the authority of Congress to enact special or private legislation, such as Private Law 1008, cannot rest on an inherent law-making power of the sovereign, but can arise *only* to the extent that specifically delegated authority therefor can be found *within the terms of the Federal Constitution*, notably Article I, Section 8.[39]

Guided by these principles, this Court has sustained special legislation authorizing the *payment of money* to individuals injured by governmental acts—*not* on the basis of a constitutional delegation of the general sovereign power to enact special legislation, but rather under the specifically delegated power "to lay Taxes . . . to pay the debts . . . of the United States . . ."

---

dressed to the House by individuals containing requests for the alteration of an existing right, or the creation of a new right, as well as petitions addressed to the Crown as a constituent part of Parliament, and containing requests for the creation of a new general right, led up to legislative acts, that is, were disposed of by agreements of the Commons with the Upper House and the Crown. Thus from the very beginning the two great branches of English legislation, private and public, had a common mode of initiation, namely, by petition." [*]

[39] The fact of nondelegation of the general sovereign authority to enact private laws is manifest in the circumstance that essentially all of the States have recognized such authority to reside only in the States, and to safeguard the welfare of their citizens have constitutionally limited its exercise. *See* I. H. Cloe and S. Marcus, "Special and Local Legislation," 24 Kentucky Law Journal 351 (1936).

(Article 1, ~~8~~, Cl. 1). *United States* v. *Realty Co.*, 163 U. S. 427, 41 Led. 215 (1896).[39]

Since no form of redress of a government obligation to a citizen save the payment of money is cognizable under the Constitution, Private Law 1008 cannot be sustained.

Respectfully submitted

EDWARD S. IRONS
HAROLD J. BIRCH

Of Counsel:

IRONS, BIRCH, SWINDLER & McKIE
One Thousand Connecticut Avenue, N.W.
Washington 6, D. C.
Attorneys for Appellant

December 6, 1962

[39] The decision in *United States* v. *Realty Co.* was followed in *Cincinnati Soap Co.* v. *United States*, 301 U. S. 308, 81 L. ed. 1172 (1932). To the same effect is *Pope* v. *United States*, 323 U. S. 1, 89 Led. 3 (1944). Thus, an inventor who asserts a claim against the United States for expenses incident the development of and benefit from the use of an unpatented invention must turn to Congress for payment of his claim as a moral obligation. *Patton* v. *United States*, 75 F. Supp. 470 (Ct. Cl., 1948).

APPENDIX A

IN THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF MARYLAND

CIVIL ACTION No. 12,096

RADIO POSITION FINDING CORPORATION,

Plaintiff.

VS.

THE BENDIX CORPORATION,

Defendant.

* * * * *

Filed: June 8, 1962.

Before Sobeloff, Chief Judge, United States Court of Appeals for the Fourth Circuit, R. Dorsey Watkins, and Winter, District Judges.

Messrs. Richard S. Wright, William B. Hall, Nelson Moore and Elliott I. Pollock, Attorneys for Plaintiff.

Messrs. Benjamin C. Howard, Harold J. Birch, Edward S. Irons and William W. Beckett, Attorneys for Defendant.

WINTER, District Judge:

Plaintiff, an assignee of Patent No. 2,803,819, sued defendant for infringement. The patent was issued to Colonel W. R. Blair on August 20, 1957, upon his application dated June 7, 1945, (a) after a previous application had been rejected by the Patent Office as not filed within the one-year time limitation embodied in 35 U.S.C.A. (1954), 102(b),[1] and (b) after the enactment of Private Law 1008, approved September 27, 1950, to relieve Blair of this requirement.

[1] 35 U.S.C.A. (1954), § 102(b), reads:

"A person shall be entitled to a patent unless —

* * * *

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States

* * *"

When defendant, by its motion for a declaration of invalidity and for a permanent injunction restraining the enforcement of Private Law 1008, interposed the defense, *inter alia*, of the unconstitutionality of the statute, a three judge court was convened pursuant to 28 U.S.C.A. (1950), 2282 and 2284.[1]

The patent which was issued for an Object Locating System (the electronic device commonly known as radar), describes the invention as follows:

> "This invention relates to a radio system comprising transmitting and receiving elements for the location of distance objects.
>
> "More particularly, the invention relates to a method and means for determining the position of distant objects by means of reflected radio waves, and the detection or discovery of the presence of invisible objects, such as enemy aircraft, and the determination of their position in range and direction with sufficient rapidity and accuracy as to be of immediate use, such as to anti-aircraft gunners."

Blair's original patent application having been rejected, Private Law 1008 was enacted by the 81st Congress, and approved by the President, upon the representations made to both Senate and House Committees on the Judiciary that Major William R. Blair, Signal Corps (now Colonel William R. Blair, U. S. Army, retired), had conceived this invention at an early date and gradually evolved it to the system described in the patent and had demonstrated it

[1] 28 U.S.C.A. (1950), § 2282, reads:

> "An interlocutory or permanent injunction restraining the enforcement, operation or execution of any Act of Congress for repugnance to the Constitution of the United States shall not be granted by any district court or judge thereof unless the application therefor is heard and determined by a district court of three judges under section 2284 of this title."

§ 2284 establishes the composition and the procedure for the three judge court.

before a group of high Government officials a few years before World War II, but that Major Blair had been specifically ordered by his commanding officer to keep the invention secret and not to file a patent application thereon. The text of the Act is set forth below.

Defendant's briefs and oral argument took a wide range. Defendant asserts the invalidity of Private Law 1008 because (a) it does not grant an "exclusive right" within the meaning of Article 1, § 8, Clause 8, of the Constitution, since it purports to preserve the rights of persons manufacturing or using the invention authorized to be patented, or in possession of any rights in a conflicting patent or application for a patent, (b) the statutory bar of one year prescribed by 35 U.S.C.A. (1954), § 102(b), had become effective against Blair, hence his invention had entered the pub-

"AN ACT

"(to correct possible inequity in the case of a certain application for letters patent of William R. Blair).

"BE IT ENACTED BY THE SENATE AND HOUSE OF REPRESENTATIVES OF THE UNITED STATES OF AMERICA IN CONGRESS ASSEMBLED, That notwithstanding any provision of existing law, the application for United States letters patent of William R. Blair, Serial No. 598,167, filed June 7, 1945, for Object Locating System, shall not be rejected nor shall any patent granted on said application be held invalid by reason of the fact that the invention disclosed in said application was patented or described in a printed publication in this or any foreign country, or was in public use or on sale in this country, unless the effective date of such patent, publication, public use, or sale, is prior to the date of said invention by the said William R. Blair: PROVIDED, HOWEVER, that the holder of any patent granted under this Act shall not, except to the extent of requiring the payment of a reasonable fee or royalty, be entitled to enforce his patent rights thereunder against any person, who, before the passage of this Act, was lawfully manufacturing or using the invention covered by such patent, or was bona fide in possession of any rights in a patent or application for patent conflicting with such patent so issued.

"Approved September 27, 1950."

lic domain, and Private Law 1008 undertaking to allow him thereafter to obtain a patent was in derogation of an existing right of the public, thereby denying substantive due process of law, and (c) the effect of Private Law 1008 was to deny procedural due process to holders of other conflicting patents to contest priority of invention.

Defendant argues the equities of the respective parties, questions the motivations underlying the legislation and the genuineness of the reasons asserted in the Congressional committee reports in support of the legislation, and questions whether, in actuality, the special law accomplishes what its sponsors professed and even whether they and Congress fully understood the consequences of the legislation.

A substantial portion of this argument presents considerations which are not for us to weigh and determine. The function of this three-judge court is the limited one of deciding whether the Act is repugnant to the Constitution of the United States, and we think that there are only three grounds of constitutional attack which merit our consideration, namely, whether Private Law 1008 violates the concept of exclusiveness contained in Article 1, § 8, Clause 8, whether Private Law 1008 denies substantive due process to those persons whose rights in the invention vested before the enactment of the law, and whether Private Law 1008 denies procedural due process by preventing a priority contest in the Patent Office.

A. Exclusive Right.

Defendant bottoms its first argument on the patent clause of the Constitution (Article 1, § 8, cl. 8), which gives Congress the power "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the *exclusive* Right to their respective Writings and Discoveries." (Italics supplied).

We have found no cases which hold that Congress lacks the authority to grant a patent, or by general law to pro-

vide for the granting of a patent, under circumstances where the rights of persons, other than the patentee or his successor in interest, arising prior to the grant of the patent are afforded at least some protection. A consideration of the case law, as well as various statutes dealing with patents, leads us to the conclusion that Congress undoubtedly possesses the power.

We perceive no real distinction between protection of intervening rights in the case of issuance of a patent in the first instance and the case of reissuance of a patent. In regard to the latter, prior to 1832 "there was no mention in the statutes of any way in which any patent, once granted, could be extended and its duration thus prolonged." 2 Walker, *Patents* (1937 Ed.), § 230, p. 1172. This state of the law was changed by the passage of the Act of July, 1832, 4 Stat. at L., ch. 162, § 2, p. 559, but it, in turn, was repealed by the Patent Act of July 4, 1836, 5 Stat. at L., ch. 357, § 21, p. 125.

Prior to 1832 the case of *Evans v. Jordan*, 9 Cranch 199, 13 U. S. 199 (1815), was decided. That case was a suit for damages for infringement. It appeared that after a patent issued to Evans had expired and, moreover, had been judicially declared void, defendant erected machinery covered by the expired and voided patent. In 1809, Congress passed an Act authorizing the Secretary of State to issue to Evans a patent for fourteen years, "provided, that no person who may have heretofore paid the said Oliver Evans for license to use the said improvements, shall be obliged to renew said license, or be subject to damages for not renewing the same; and, provided also, that no person who shall have used the said improvements, or have erected the same for use, before the issuing of the said patent, shall be liable to damages therefor."

The case decided that defendants would be liable for damages prospectively from the date of reissuance of the pat

cut. In commenting upon counsel's argument that such a result was harsh, the Court said (6 Cranch 202-203):

> . . . The provisos in this law profess to protect against the operation of the general law, three classes of persons: those who had paid Evans for a license prior to the passage of the law; those who may have used his improvements; and those who may have erected them for use, before the issuing of the patent. The legislature might have proceeded still further, by providing a shield for persons standing in the situation of these defendants. It is believed that the reasonableness of such a provision could have been questioned by no one. . . . .

With the passage of the Patent Act of July 4, 1836, *supra*, and subsequent amendments thereto, authority to extend patents was lodged in the Patent Office and various officials and agencies thereof. One basic requirement was that application for extension must be made before the expiration of the patent sought to be extended. When John Goulding, to whom a patent was issued on December 15, 1836, reissued on July 2d, 1838, and then expired December 2, 1842, by reason of his reliance upon erroneous information given him by the Commissioner of Patents, failed to make a timely application for reissuance, Congress, on May 30, 1862, enacted a private law authorizing the Commissioner of Patents to grant the extension of the patent or to withhold it, the same as if the application had been seasonably made, "provided that the renewal and extension shall not have the effect, or be construed, to restrain persons who may be using the machinery invented by said Goulding at the time of the renewal and extension, hereby authorized, from continuing the use of the same, nor subject them to any claim or damage for having so used the same." By the time the Commissioner of Patents reissued the patent, nearly seventy years had elapsed from the expiration of the term for which it was originally issued.

The validity of this statute was upheld in *Evans' Patent*, 3 Wheat. 454 (U. S. 1818).

The Goulding private law was involved in *Aquaroon Co. v. Jordan*, 7 Wall. 583, 74 U. S. 583 (1868), where Goulding's assignee sued for infringement. It was held that in the light of the proviso, Goulding's assignee could not recover damages for any period antecedent to the date of the reissued patent.

The Fire Extinguisher Case, 21 F. 40 (C. C., Md. 1884), *infra alia*, concerned the validity of the Act of June 14, 1878, which relieved the heirs of William A. Graham from all disabilities preventing them from renewing or reviving an application filed by Graham in 1857 for a patent for a fire extinguisher. The original application was refused by the Commissioner of Patents and abandoned by the inventor, who then died in 1857. After a fire extinguisher patent was granted to someone else in 1869, based upon an alleged invention in 1861, and successfully voided by proof of invention by Graham and demonstration in 1862 or 1863, Graham's administrator sought to obtain a patent. When he was refused, the Act of Congress ensued.

The Act authorized the administrator to renew the 1857 application and authorized the Commissioner of Patents to issue a patent "provided, that all persons having machines, containing the inventions, in use should have the right to continue to use them without being liable for any infringement." (p. 42)

Judge Morris sustained the validity of the Act, saying (pp. 42-43):

> "... With regard to the terms upon which the exclusive right shall be granted, the time when the application for the original grant or for any renewal or extension of it shall be made, it has been frequently held that the regulations in these matters are merely self imposed restrictions on the constitutional power of congress, which it can at its pleasure disregard in any particular case. Walker, Pat. 250.
>
> "Special acts for the relief of particular inventors have often been passed by congress. *Evans v. Eaton*,

3 Wheat. 454. In the case of *Aquawam Co.* v. *Jordan*, 7 Wall. 583, the supreme court sustained a patent which had been extended in pursuance of a special act of congress, passed more than 20 years after the original patent had expired, and the invention had been free to the public. The act of congress in that case was quite similar to the one under consideration, in that it authorized the commissioner to entertain the application for extension as though it had been made within the time prescribed by the general law. In *Blanchard* v. *Sprague*, 2 Story, 170, Mr. Justice Story, speaking on the right of congress to grant a patent to an inventor whose invention had, at the time of the passage of the act, gone into public use, says that the question is set at rest by *Evans* v. *Eaton*, and that he had never doubted the constitutional authority of congress to make such a grant:

"The right which the public has acquired to use the thing invented, by reason of the applicant for a patent failing to do something prescribed by congress, and the necessity for which congress might, by previous legislation, have dispensed with, has never been held to be a vested right. The cases of *Evans* v. *Eaton*, *supra*; *Evans* v. *Jordan*, 9 Cranch, 199; *Bloomer* v. *Stolley*, 5 McLean, 161; *Jordan* v. *Dobson*, 2 Abb. (U. S.) 408, hardly leave this question debatable."

Not without significance also is *United States* v. *National Lead Co.*, 332 U. S. 319 (1947). That case was a civil action to enjoin violations of §§ 1 and 2 of the Sherman Anti-trust Act. Violation of the Act was found, *inter alia*, through the pooling of patents, and the main question on appeal concerned the form of the final decree.

The District Court ordered that with respect to certain patents the defendants were obliged to grant licenses to any applicant therefor at reasonable royalties. This portion of the decree was affirmed by the Supreme Court. Thus, the Court approved a modification of the original exclusive nature of the patent albeit under circumstances differing from those in the case at bar.

The long standing judicial recognition of flexibility in the "exclusive" concept of patents is embodied in the present patent statutes. There is presently no general act for extension of patents.* Indeed, 2 Walker, *supra*, § 228, p. 1168, states, "Patents can now be extended only by special acts of congress." There is, however, statutory authority for the reissue of defective patents, 35 U.S.C.A. (1954), § 251, and special provision is made by general law of rights which may come into being antecedent to the issuance of a valid patent, 35 U.S.C.A. (1954), § 252. That statute provides, in part:

> "No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which substantial preparation was made before the grant of the reissue, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the practice of which substantial preparation was made, prior to the grant of the reissue, to the extent

* The last extension statute was the act of June 30, 1950, ch. 444, 64 Stat. 316, which gave extension rights to persons who served in World War II. The Act was limited to persons who within one year after its enactment made application to the Commissioner of Patents and complied with its provisions. The Act has now been eliminated from the U. S. Code. The Act provided, however, in similar terms to those adopted in the Private Act for Blair, that [extension] rights thereunder as respects persons bona fide possessing or manufacturing the patented article prior to the extension would only be subject to payment of reasonable royalties to the patentee upon granting of his extension.

> and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue."

The direct and indirect expressions of approval of various private laws which have modified the exclusiveness of the grant to the patentee and the long legislative history of the exercise of congressional power to modify the exclusiveness of a patent grant, dating, indeed, from shortly after the adoption of the Constitution, lead us to conclude that Congress did not violate Article 1, § 8, cl. 8 of the Constitution in the enactment of Private Law 1008.

B. Substantive Due Process.

Defendant's substantive due process argument consists of two parts. First, defendant, as a member of the public, claims that it and other members of the public acquired a vested right in the invention because of Blair's failure to seek a patent within the time prescribed by law and the passage of the invention into the public domain. It argues that to require it and them to pay a royalty from the date of issue of the Blair patent will deny this property right. Defendant argues, second, that Private Law 1008 is a special, discriminatory law which violates the concept of fair play under the Fifth Amendment in the opprobrious sense of a denial of equal protection of the laws under the Fourteenth Amendment.

From the authorities cited in response to defendant's "exclusive" argument, the cases dealing with reissue and extension of patents, and particularly the language of Judge Morris in *The Fire Extinguisher Case*, *supra*, defendant is in error when it argues that it and the public acquired a property right in the Blair invention by reason of Blair's failure to pursue a timely application for a patent, and that this right is one entitled to the protection of the due process clause.

Insofar as defendant's argument on this point is concerned, Private Law 1008 did nothing more than waive the statute of limitations contained in 35 U.S.C.A. (1954), § 102(b).* In Federal jurisprudence statutes of limitations are not generally considered to create vested rights in those whose obligations are barred from enforcement. In *Campbell* v. *Holt*, 115 U. S. 620 (1885), in holding valid a state constitutional provision which removed the bar of a statute of limitations, the Court stated (p. 628):

> "The statutes of limitations, as often asserted, and especially by this Court, are founded on public needs and public policy—are arbitrary enactments by the law making power. * * * The authorities we have cited, especially in this Court, show that no right is destroyed when the law restores a remedy which had been lost."

A later expression is contained in *Chase Securities Corp.* v. *Donaldson*, 325 U. S. 304 (1945), where, again, the validity of a state enactment removing a previous bar of limitations was in issue. In sustaining the validity of the law, the Court said (p. 314):

> "Their shelter [speaking of limitations statutes] has never been regarded as what is now called a 'fundamental' right or what used to be called a 'natural' right of the individual. He may, of course, have the protection of the policy while it exists, but the history of pleas of limitations shows them to be good only by legislative grace and to be subject to a relatively large degree of legislative control."

William Danzer Co. v. *Gulf R. R.*, 268 U. S. 633 (1925), cited by defendant, is not to us persuasive. In that case the act held invalid purported to extend the time limitation in an earlier law creating a remedy. Right and remedy were inextricably mixed, so that removal of the bar of limi

* It should be noted that not until the Patent Act of 1870, 16 Stat. 201, was any time limit imposed on an applicant for a patent to make his application.

tations constituted the creation of an additional remedy. As our previous footnote 4 shows, limitations are a comparatively recent innovation in the patent statutes. They were not introduced until eighty years from the first general patent law and they bespeak more in the nature of true statutes of limitations than the act questioned in *Danzer*.

We think defendant and the public acquired no property right of which they have been denied.

Unlike the Fourteenth Amendment which is applicable to the states, the Fifth Amendment which is applicable to the federal government, contains no specific equal protection clause. But "due process" as guaranteed by the Fifth Amendment includes, at least in part, "equal protection" as guaranteed by the Fourteenth Amendment. *Bolling* v. *Sharpe*, 347 U. S. 497, 499 (1954). Due process prohibits Congress from enactments which shock the sense of fair play, *Galvan* v. *Press*, 347 U. S. 522, 530 (1954). Thus, the essential question is whether the purported justification for Private Law 1008 is so arbitrary and unreasonable that it offends due process, *Fleming* v. *Nestor*, 363 U. S. 603 (1960). As recently as *McGowan* v. *Maryland*, 366 U. S. 420 (1961), in dealing with the stricter prohibition against discriminatory legislation contained in the equal protection of the laws clause, the Court stated (p. 426), "A statutory discrimination will not be set aside if any state of facts reasonably may be conceived to justify it."

We cannot say, in spite of defendant's extensive arguments to the contrary, that Congress had no basis on which to conclude that Colonel Blair was entitled to special relief. Especially is this so when Congress, in the exercise of its authority under the patent clause, was not laboring under a requirement of uniformity such as is found in other clauses of Article I, § 8 of the Constitution, and when in granting relief Congress was more protective of intervening rights than in many of the special acts recited in

an earlier section of this opinion. Defendant's arguments are not properly addressed to this Court. They should have been addressed to Congress and not to us.

C. Procedural Due Process.

The remaining contention to be considered is defendant's claim of denial of procedural due process. The argument stems from the favorable report of the Senate Judiciary Committee (S. Rep. 1665, 81st Cong. 2d Sess. (1950)), which stated:

> "This bill will not assure the granting of a patent to Colonel Blair. *This bill is for the purpose of enabling Colonel Blair to contest priority in the United States Patent Office as to his invention with other parties claiming the same invention.* Thus, if Colonel Blair is unsuccessful in proving that he is the prior inventor, no patent will issue to him. *This bill would give no special advantage as to priority or patentability to Colonel Blair*, nor does this bill ask that any determination involving patentability or priority be waived by the Patent Office." (Italics supplied).

Defendant advises us that by reason of Colonel Blair's naked claim of invention at such an early date the regular procedures of the Patent Office with regard to an interference proceeding were considered by the latter to be inapplicable, so that other radar claimants, for example those claiming under Gloess, Serial No. 231,166, filed September 22, 1938, who relied upon an application for a French patent, two British patents and a United States patent, were denied an effective forum to litigate priority of invention in the Patent Office.

As discussed in 2 Walker, *supra*, § 189, p. 889, *et seq.*, the essential function of an interference proceeding is to determine priority of invention between two or more parties.

The legislative intent expressed in Private Law 1008 and the proceedings leading to its enactment was not to circum-

vent the usual administrative consideration of the Blair patent application, so that any departure on the part of the Patent Office from its usual procedures and any failure on the part of the Patent Office fully to consider interference would seem to arise from a misconception of the purpose and meaning of the Act. But we cannot say that such failure amounts to denial of procedural due process. The assignee of the Blair patent has instituted suit for infringement in this Court. Finding as we do, that Congress, in enacting Private Law 1008, validly exercised its power to grant patents and that there are no substantive due process objections to the Act, it necessarily follows that the entire validity of the Blair patent, including the question of prior invention, may be raised, litigated and decided in this Court. Procedural due process is thus fully served.

In the light of our conclusion, it is unnecessary for us to consider plaintiff's claim that the constitutionality of Private Law 1008 may be sustained under the war powers of Congress, Constitution, Article 1, § 8, cl. 11. Nor do we express any opinion as to the merit or validity of the patent.

Defendant's motion for a declaration of invalidity of Private Law 1008 and for a permanent injunction restraining the enforcement of said law is denied. The three-judge court is dissolved, and the case to remain on the docket for trial in regular course.

HARRISON L. WINTER
United States District Judge

APPENDIX B

IN THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF MARYLAND

CIVIL ACTION NO. 12,096

RADIO POSITION FINDING CORPORATION

Plaintiff

v.

THE BENDIX CORPORATION

Defendant

Order of Court

It is this 10 day of July, 1962, by the United States District Court for the District of Maryland

ORDERED that the Defendant's Motion for a Declaration of Invalidity of Private Law 1008 and for a permanent injunction restraining the enforcement of said law, be and the same hereby is denied.

Chief Judge, United States Court of Appeals for the Fourth Circuit

District Judge, United States District Court for the District of Maryland

District Judge, United States District Court for the District of Maryland

APPENDIX C

CALENDAR No. 1675

81ST CONGRESS, 2d Session—SENATE—REPORT No. 1665

CORRECTING POSSIBLE INEQUITY IN THE CASE OF A CERTAIN APPLICATION FOR LETTERS PATENT OF WILLIAM R. BLAIR

MAY 17 (legislative day, MARCH 29), 1950.—Ordered to be printed

Mr. WILEY, from the Committee on the Judiciary, submitted the following

REPORT

[To accompany H. R. 577]

The Committee on the Judiciary, to whom was referred the bill (H. R. 577) to correct possible inequity in the case of a certain application for letters patent of William R. Blair, having considered the same, report favorably thereon, with an amendment, and recommend that the bill, as amended, do pass.

AMENDMENT

On page 2, line 2, following the word "Blair", change the period to a colon and add the following:

Provided, however, That the holder of any patent granted under this Act shall not, except to the extent of requiring the payment of a reasonable fee or royalty, be entitled to enforce his patent rights thereunder against any person who, before the passage of this Act, was lawfully manufacturing or using the invention covered by such patent, or was bona fide in possession of any rights in a patent or application for patent conflicting with such patent so issued.

PURPOSE OF AMENDMENT

During the hearings the question arose concerning the present and future rights of parties now manufacturing, selling, etc., the device which Colonel Blair claims he invented and which will be the subject matter of interference proceedings. The danger was feared that Colonel Blair, after enactment of the proposed legislation, might possibly be the victor in the interference proceedings and emerge with a basic patent, and that under existing law he could prohibit the manufacture of the invention or its sale or use, or he had the option of driving an unconscionable royalty bargain. The Standing Subcommittee on Patents, Trademarks, and Copyrights believe that, as to innocent persons who are presently manufacturing said invention, it is manifestly unfair to deny them the right to continue to so manufacture, since it is possible they went into said manufacture expending large sums for capital investment relying on the fact that Colonel Blair was barred by the cited prohibition statutes. The same conclusion is considered true in connection with the persons who may have obtained patents or filed applications for patents, which would be dominated by any patent granted to Colonel Blair.

For the foregoing reasons, the subcommittee inserted a proviso stating to the effect that any patent granted under this act shall not impair the right of such persons, but any such persons shall have the right to make, use, and vend the invention during the term of the patent, subject to the payment of a reasonable charge or royalty.

Thus, to summarize and conclude the subject proviso amendment in effect simply protects the rights of intervening parties and thereby accomplishes a more equitable solution of the party's difficulties.

STATEMENT

The bill carries the favorable endorsement of the Department of the Army and of the Department of Justice.

It is understood from the Patent Commissioner's office that enactment of the legislation in that Department's point of view is a matter of legislative policy.

This is a bill to remove the statutory bars now contained in Revised Statutes 4886 with respect to the patent application of William R. Blair, serial No. 598,167, filed June 7, 1945, for "Object locating system." Revised Statutes 4886 states in part that a person will be barred from receiving a patent if his invention was patented or described in any printed publication in this or any foreign country before his invention thereof or more than 1 year prior to the filing of his patent application.

The said William R. Blair is now barred from receiving a patent on his invention or of contesting the priority of invention as between others who are claiming the same patentable subject matter because his invention was described in a publication having an effective date more than 1 year prior to the filing of the Blair application.

This bill would remove the afore-mentioned statutory bars which now prevent the said William R. Blair from receiving a patent, or fairly and equitably contesting priority of invention in accordance with the provisions of Revised Statutes 4904 as between himself and other applicants for patent claiming the same patentable subject matter. Revised Statutes 4904 empowers the Patent Office to declare an interference between a pending application and any other pending application or unexpired patent which claims the same patentable subject matter. This procedure is set up to determine the first inventor of patentable subject matter that is being claimed by other inventors.

Maj. William R. Blair, Signal Corps (now Col. William R. Blair, U. S. Army, retired), claims that he conceived this invention at an early date and gradually evolved it to the system set forth in the patent application referred to above, which invention was demonstrated before a group

of high Government officials a few years before World War II. At that time, Major Blair was specifically ordered by his commanding officer to keep the invention secret and not to file a patent application thereon.

Soon after this demonstration, Colonel Blair was retired from the Army. The personnel in the Signal Corps responsible for patents was shifting and changing at that time, with the result that it was only after the security classification of that invention was reduced and an investigation into the early work done by Signal Corps personnel in radar that the invention of Colonel Blair was uncovered and a patent application prepared and filed by the Signal Corps.

This bill will not assure the granting of a patent to Colonel Blair. This bill is for the purpose of enabling Colonel Blair to contest priority in the United States Patent Office as to his invention with other parties claiming the same invention. Thus, if Colonel Blair is unsuccessful in proving that he is the prior inventor, no patent will issue to him. This bill would give no special advantage as to priority or patentability to Colonel Blair, nor does this bill ask that any determination involving patentability or priority be waived by the Patent Office.

The Government has a direct interest in this application in that it is a licensee under this invention. The invention pertains to radar, one of the most important military weapons known to modern science and which was used for the first time in the last war.

A companion bill (H. R. 6216) passed the House on June 8, 1948 (H. Rept. 2171), and was referred to the Senate Committee on the Judiciary where it died. In the rush of the closing days of the Eightieth Congress the committee discussed the bill on June 16, 1948, and ordered it passed over for additional information. The committee wanted to be certain that in the event Blair was successful

in securing his patent there would be no future liability of the Government to Blair as to royalties or license fees. The answer is in the negative; Blair is precluded from any possible future claims against the Government both by operation of law and by specific assignment royalty free to the Government.

The following departmental reports further illustrate the purpose and need for the legislation:

DEPARTMENT OF JUSTICE,
OFFICE OF THE ASSISTANT TO THE ATTORNEY GENERAL,
Washington, June 14, 1948.

Hon. ALEXANDER WILEY,
Chairman, Committee on the Judiciary,
United States Senate, Washington, D. C.

MY DEAR SENATOR: This is in response to the request of the House Committee on the Judiciary for the views of this Department relative to the bill (H. R. 6216) to correct possible inequity in the case of a certain application for letters patent of William R. Blair. As the bill passed the House of Representatives on June 8, 1948, this report is being transmitted to your committee and will also serve as this Department's report on the Senate companion bill (S. 2468).

The bill would provide for the removal of the statutory bars now contained in R. S. 4886 (35 U. S. C. 31) with respect to the application for letters patent of William R. Blair.

From the report of the Department of the Army, copies of which report accompanied the draft of the bill and were transmitted to your committee on April 7, 1948, it appears that Colonel Blair's invention relating to radar was demonstrated before a group of Government officials in May 1937. At that time, Colonel Blair requested permission to apply for a patent covering his invention and was told by the Chief of Staff that the apparatus should be kept entirely secret and that no patent application should

be filed. Subsequently, it was found desirable to begin the quantity production of radar equipment in order to promote the national defense effort, and numerous secret contracts were entered into by various manufacturers.

Under the provision of Revised Statutes 4886, Colonel Blair would be barred from obtaining a valid patent if it were established that his application was not filed within 1 year from the date of any public use, sale, publication, or prior patent disclosing his invention.

In its report the Department of the Army points out that the removal of the statutory bars referred to will not resolve the issue of the priority of invention but will merely remove the requirement that he must file his application within 2 years of the sale of such apparatus to the War Department by the manufacturing concerns which were making the apparatus for the War Department under secret contract. It will also enable Colonel Blair to challenge the applications for patents on the same subject matter filed by others. The report of the Department of the Army further states that this matter is one of interest to the United States because as licensee under the application it might possibly become subject to a suit in the event that a patent should improperly issue to an adverse claimant.

The Department of the Army states that it is unable to estimate any fiscal effects of the bill, other than to protect the United States from claims with no equitable basis.

The Department of Justice finds no objection to the enactment of the bill.

The Director of the Bureau of the Budget advises that there is no objection to the submission of the report.

Yours sincerely,

PEYTON FORD,
The Assistant to the Attorney General.

DEPARTMENT OF JUSTICE,
OFFICE OF THE ASSISTANT TO THE ATTORNEY GENERAL,
Washington, December 27, 1949.

Hon. PAT MCCARRAN,
Chairman, Committee on the Judiciary,
United States Senate,
Washington, D. C.

MY DEAR SENATOR: Your attention is invited to the bill (H. R. 377) to correct possible inequity in the case of a certain application for letters patent of William R. Blair, which bill is at present pending before your committee, and the enactment of which would serve to facilitate the work of this Department in certain patent matters now before it.

The bill would provide that notwithstanding any provision of existing law the application for letters patent of William R. Blair, filed June 7, 1945, for object locating system, shall not be rejected nor shall any patent granted on such application be held invalid by reason of the fact that the invention disclosed in the application was patented or described in a printed publication in this or any foreign country, or was in public use or on sale in this country, unless the effective date of such patent, publication, public use, or sale, is prior to the date of such invention by William R. Blair.

In commenting on a similar bill in the Eightieth Congress, the Department of Justice noted that Colonel Blair's invention relating to radar was demonstrated before a group of Government officials in May 1937. At that time, Colonel Blair requested permission to apply for a patent covering his invention and was told by the Chief of Staff that the apparatus should be kept entirely secret and that no patent application should be filed. Subsequently, it was found desirable to begin the quantity production of radar equipment in order to promote the national defense effort, and numerous secret contracts were entered into by various manufacturers.

The Department of Justice feels that, under the peculiar circumstances present in this case, there are equitable considerations in favor of its enactment.

The Director of the Bureau of the Budget has advised this office that there would be no objection to the submission of this report.

Yours sincerely,

PEYTON FORD,
The Assistant to the Attorney General.

APRIL 1, 1949.

Subject: H. R. 577, Eighty-first Congress, William R. Blair

Mr. ROBERT B. YOUNG,
Professional Staff, Judiciary Committee,
Senate Office Building.

DEAR MR. YOUNG: In accordance with my promise to you yesterday, there are forwarded herewith the following papers which are pertinent to the subject matter of the above bill:

1. Copy of letter of April 7, 1948, to Hon. Chan Gurney, chairman, Armed Services Committee, United States Senate.

2. Photostat copy of assignment.

The bill referred to in the letter of April 7, 1948, is identical in wording with H. R. 577, Eighty-first Congress. The last paragraph on page 4 of this letter points out that the Government has a license under the Blair invention. In this connection there is forwarded herewith the photostat of the license from Blair to the United States dated June 7, 1945, which is recorded in the United States Patent Office. It will be noted that the second paragraph of the granting clause of this instrument gives to the Government "an irrevocable, nonexclusive, and royalty-free right

and license * * * to make, have made, to use, and to sell the subject matter of said invention for governmental purposes * * *."

I believe that the papers forwarded herewith will answer your question regarding the right of the Government to use the Blair invention forming the subject of H. R. 577 without the necessity of paying royalties thereon. If I can be of further assistance to you in this matter, please so advise me.

Sincerely yours,

GEORGE W. GARDES,
Colonel, Judge Advocate General's Corps, Chief, Patents Division.

DEPARTMENT OF THE ARMY,
Washington, April 7, 1948.

Hon. CHAN GURNEY,
Chairman, Armed Services Committee,
United States Senate.

DEAR SENATOR GURNEY: There is enclosed herewith draft of a bill to correct possible inequity in the case of a certain application for letters patent of William R. Blair, which the Department of the Army recommends be enacted into law.

The purpose of the proposed legislation is to remove the statutory bars now contained in Revised Statutes 4886 (35 U. S. C. 31), with respect to the application of William R. Blair, Serial No. 598,167, filed June 7, 1945, for object locating system, in order that the said William R. Blair will not be prevented by reason of such statutory bars from receiving a patent or fairly and equitably contesting priority of invention in accordance with the provisions of Revised Statutes 4904 (35 U. S. C. 52), as between himself and other applicants for patents claiming like subject mat-

ter, to the possible detriment of the interests of the United States under the application in question and the invention described and claimed therein.

The invention described and claimed in application Serial No. 598,167 pertains to radar, one of the most important military weapons known to modern science and which was used for the first time in the present war. Maj. William R. Blair, Signal Corps (now Col. William R. Blair, United States Army, Retired) claims that he conceived the present invention. The basic conception, he claims, took form in his mind at an early date and was gradually evolved into the system set forth in the patent application referred to and was demonstrated before a group of high Government officials in May 1937.

The reduction to practice of the basic ideas involved a major laboratory research and development program and called for the expenditure of considerable funds which during the depression years 1932 to 1936 were not available to the Signal Corps Laboratories.

In the early spring of 1936 the international situation was becoming tense and the urgent need for a practical means of plane detection was brought to the attention of the Secretary of War. In a letter dated May 1, 1936, to the Chief Signal Officer, Adjutant General Collins, stated the case as follows:

3. The development of an efficient means of detecting the approach of aircraft is considered of such vital importance to all branches of the Army that it is considered essential to place it in highest priority.

4. It is therefore directed that the Chief Signal Officer provide the additional funds required for this development of the detector of aircraft by a reduction in the amounts now set up with fiscal years 1936, 1937, and 1938 for less urgent projects.

At that time, basic ideas were sufficiently advanced, that under this directive a full scale demonstration with improvided laboratory models was planned to demonstrate the feasibility of the method and to obtain the funds necessary to complete the development. This program was carried out with such promptness and efficiency that notwithstanding the complexity and difficult of the subject, a complete plane detection system was evolved and put on demonstration within a single year from the date of this directive, marking one of the most outstanding scientific achievements on record.

Those present at the demonstration at the Signal Corps Laboratories, Fort Monmouth, N. J., May 18, 1937, included the following: Senator Sheppard, chairman, Committee on Military Affairs, United States Senate, Senator Copeland, a member of the Appropriations Committee, United States Senate, Representative Harter, a member of the Military Affairs Committee, House of Representatives, Representative Snyder, a member of the Appropriations Committee, House of Representatives, Hon. Harry H. Woodring, Secretary of War, Gen. Malin Craig, Chief of Staff, United States Army, Maj. Gen. James B. Allison, Chief Signal Officer, Maj. Gen. Archibald H. Sunderland, Chief of Coast Artillery, and Brig. Gen. Henry H. Arnold, Assistant Chief, Army Air Corps.

Prior to the demonstration of May 18, 1937, General Allison had informed Major Blair by letter dated May 10, 1937, that "The Chief of Staff is extremely anxious that this project be kept entirely secret." On May 12, 1937, General Allison further informed Major Blair that "My letter to you of May 10 was simply to enable you to caution the personnel at Fort Monmouth that no reference should be made to this project in any particular, either on or off the post.

At the actual demonstration on May 18, 1937, the Chief of Staff, General Craig, expressed the opinion that further

secrecy precautions were necessary and gave orders accordingly. Major Blair specifically asked at that time if he might apply for a patent covering this invention and the Chief of Staff replied that the apparatus should be kept very secret and that no patent application should be filed. In September 1937 Major Blair was hospitalized, and upon his release from the hospital in 1938, was retired from the Army. He was not apprised of any of the subsequent Signal Corps developments in the field of radar and relied upon the patent personnel of the Signal Corps to take steps to file the necessary application covering his invention if and when conditions of military security permitted. However, because of changes in personnel and the high degree of secrecy which surrounded radar developments, the present patent personnel of the Signal Corps did not become apprised of the early work done by Major Blair, and did not discover the true history of his early development, until 1943; thereupon the above-mentioned application for patent was prepared and filed in the Patent Office.

After Major Blair left the Signal Corps Laboratories at Fort Monmouth, as above stated, the Signal Corps found it desirable to begin the quantity production of radar equipment in order to promote the national defense effort, and to that end placed numerous secret contracts with various manufacturers. As a result of this program, it was not long before numerous manufacturers were making developments in radar equipment and components thereof, and undoubtedly filing applications for patents based thereon. Furthermore numerous commercial concerns and individuals throughout the country have publicly claimed to have invented radar at various times and have no doubt filed applications for patents, which if allowed by the Patent Office might well dominate the early work of Colonel Blair and the Signal Corps in this field.

The present law relating to the granting of patents, when there are several applicants each claiming the same inven-

tion, is Revised Statutes 4904 (35 U. S. C. 52), which reads as follows:

"Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor."

Under this provision, Colonel Blair would be able to contest the question of his priority of invention with any adverse claimant were it not for the practice of the Patent Office (which is undoubtedly proper in view of existing law) in refusing to institute interference proceedings in the event one of the parties is completely barred from obtaining a patent. Under the provisions of Revised Statutes 4886, supra, Colonel Blair may be barred from obtaining a valid patent if it is established that his application was not filed within 1 year from the date of any public use, sale, publication or prior patent disclosing his invention.

The proposed bill will not resolve the issue of priority of invention in favor of Colonel Blair. It will merely remove the requirement that Colonel Blair must have filed his application within 2 years of sale of such apparatus to the Government by the manufacturing concerns who were making the apparatus for the Government under secret contract; it will remove the bars of publication in event the manufacturing concerns or others have actually published the invention within the meaning of the law; and it will enable Colonel Blair to challenge the applications for patents filed by others who claim to have invented similar subject matter. It is apparent that the proposed bill does not change Revised Statutes 4904, supra, concerning the practice of determining the real question of priority of invention.

The matter has an importance to the United States Government itself, since the invention was developed in laboratories of the United States Government and, as above stated, the Government is licensed under the application and the invention. If, due to present statutory bars, a fundamental patent should improperly issue to adverse claimants and a suit were to be brought thereon against the United States after witnesses having personal knowledge of Colonel Blair's early work have died, as some have already, it would be difficult for the Government to prove the true facts concerning this matter in defending itself against suit in the Court of Claims. It is one of the main purposes of the proposed bill to save the Government from paying claims for royalties for patents which may be granted because Colonel Blair is presently barred by statute from presenting evidence of his earlier developments which he at the proper time was directed in the interest of the security of the United States from disclosing.

The Department of the Army is unable to estimate any fiscal effects of the bill, other than to protect the United States from claims with no equitable basis.

The Bureau of the Budget has been consulted and advises that there is no objection to the submission of this proposed legislation for the consideration of the Congress.

Sincerely yours,

KENNETH C. ROYALL,
Secretary of the Army.

DEPARTMENT OF THE ARMY,
OFFICE OF THE CHIEF SIGNAL OFFICER,
Washington 25, D. C., February 13, 1948

Memorandum for: Mr. James C. Auchincloss.

Subject: H. R. 4260.

1. This is in response to your oral inquiry relative to H. R. 4260, a bill to correct possible inequity in the case

of a certain application for letters patent of William R. Blair.

2. Much of the basic development work in radar was done in the Signal Corps. Because of the secret nature of the work no application for a patent was filed at the time. Thereafter contracts were placed with various concerns in order to arrive at a model which could be produced in necessary quantities. As a result, it was not long before numerous concerns and individuals outside the Government service were making developments in radar equipment and components thereof and filing applications for patents based thereon.

3. In 1945, a review of the work done at the Signal Corps Laboratories immediately prior to and during the war disclosed evidence to support the claim that William R. Blair, a Signal Corps officer, had made a basic invention in radar and accordingly the Government filed an application (Serial No. 508167) for an object-locating system in his name.

4. This application has not been allowed by the Patent Office for the reason that the application was not filed within a year (as required by law) of the sale of radar apparatus to the War Department by manufacturers who were making the equipment under contract.

5. Under this state of affairs, the Signal Corps cannot have the question of priority of invention over nongovernmental claimants tested, with the result that the government may have to pay royalties for future manufacture to some patentee who in fact is not the first inventor of the subject matter of the Blair application.

6. If the Blair application is allowed and the test of priority of invention is favorable, the Government will receive at least a free license and will therefore not have to pay royalties for the use of the invention. Because of the foregoing, the Signal Corps recommended in June 1947 that the War Department sponsor a bill having a purpose similar to H. R. 4250. The recommendation was acted

upon, and a proposed bill is presently with the Bureau of the Budget for advice whether the legislation would be in accord with the program of the President.

7. It is to be noted that neither H. R. 4260 nor the War Department sponsored bill will of itself have the effect of a grant of a patent. The proposed legislation merely removes the statutory bars against the Blair application so as to permit it to get into interference with adverse claimants on the question of priority.

S. B. Akin,
Major General, Chief Signal Officer.

Serial No. 598,167,
filed June 7, 1945.

ASSIGNMENT

Whereas I, William R. Blair, a citizen of the United States of America, of 1612 Manchester Lane, NW., Washington, District of Columbia, have invented certain improvements in Object Locating System for which the undersigned on even date herewith executed an application for Letters Patent of the United States; and

Whereas the Government of the United States is desirous of acquiring the entire right, title and interest in and to the said invention and in and to any patents that may issue thereon:

Now, Therefore, in consideration of the premises and one dollar ($1.00), the receipt of which is hereby acknowledged, the undersigned has sold, assigned and transferred, and by these presents does hereby sell, assign and transfer unto the Government of the United States of America, as represented by the Secretary of War, the entire right, title and interest, throughout the United States of America, and the territories and dependencies thereof, and not elsewhere, in and to the said invention and to the invention as

described in the specification executed by the undersigned on even date herewith, preparatory to obtaining Letters Patent in the United States therefor, and to all Letters Patent issuing thereon and any continuations, continuations-in-part, divisions, reissues, or extensions of such Letters Patent; the said entire right, title and interest as well as the control of the prosecution of the application and all continuations, continuations-in-part, divisions, reissues, or extensions thereof as where are or that may be granted, to be held by the Government as fully and entirely as the same would have been held by me had this assignment and sale not been made. The undersigned hereby gives the Government of the United States of America the non-exclusive right to make, use or sell the said invention for governmental purposes in all foreign countries.

Provided, however, That upon any subsequent notice of allowance of said application or of any substitutions, divisions, continuations, or continuations-in-part being given by the Commissioner of Patents, or upon the declaration by the Commissioner of Patents of an interference involving said application or any substitutions, divisions, continuations, or continuations-in-part, the entire right, title and interest in and to said invention and said application or any substitutions, divisions, continuations, or continuations-in-part, and such patents as may be issued thereon will thereupon revert to himself subject to an irrevocable, non-exclusive, and royalty-free right and license remaining vested in the United States of America as represented by the Secretary of War, to make, have made, to use, and to sell the subject matter of said invention for governmental purposes, to the full end of the term or terms for which any Letters Patent, divisions, reissues, extensions, continuations, or continuations in-part are or may be granted.

WILLIAM R. BLAIR,
WILLIAM D. HALL,
Witness.

Before me, a notary public in and for the State of Virginia, County of Arlington, appeared the above-named William R. Blair, personally known to me, who in my presence executed the foregoing assignment and acknowledged that his execution thereof was his free act and deed.

Signed at Arlington County, Va., this 7th day of June, 1945.

[SEAL]

BERTIE M. POSTON,
Notary Public.

My commission expires April 15, 1947.

Recorded United States Patent Office, October 6, 1947.

LAWRENCE C. KINGLAND,
Commissioner of Patents.

APPENDIX D

HOUSE OF REPRESENTATIVES.

52d Congress, *1st Session.*

Report No. 1494.

STATUTES RELATING TO PATENTS

May 25, 1892—Committed to the Committee of the Whole House on the state of the Union and ordered to be printed.

Mr. Buchanan, from the Committee on Patents, submitted the following

REPORT:

[To accompany H. R. 6071]

The Committee on Patents, to whom was referred the bill (H. R. 6071) revising and amending the statutes relating to patents, would respectfully submit the following report:

The proposed legislation deals with several features of the existing system. The nature of these provisions, the scope and effect of each proposed change, and the reasons impelling thereto will be dealt with under a separate head. These will be better understood if, primarily, we examine the system as a whole, its origin, and subsequent development.

THE ORIGIN OF OUR PRESENT LAW.

We derive our conception of the granting of letters patent, conferring a monopoly of production or use of a machine, or composition of matter, or new and useful improvement therein for a time limited by such letters from Great Britain. The practice had there grown up of con-

ferring patents by the Crown, without the existence of any statute law authorizing their issue. A favorite at court, the needy relative of some powerful man, a lucky schemer, was given the sole right by royal grant to produce certain articles or to furnish certain supplies. These patents were originally monopolistic grants for the full use or traffic in articles long known to a very large degree. But few of them were for the sole enjoyment of home need, invention, or discovery.

The abuse of this power became so great that in 1624, during the reign of James I, Parliament passed the famous statute of "monopolies," cutting off the monopolies granted by the King, but excepting from the operation of the act "letters patent and grants of privilege for a term of twenty-one years or under, heretofore made, of the sole working or making of any manner of new manufacture, within this realm, to the inventor or inventors of such manufacture."

It will be noticed that although the statute in terms does not give the Crown the right to grant letters patent, for the sole working of any new manufacture, to the first inventor of such manufacture, yet it so accurately and carefully defines the exception that it really becomes an inferential authorization so to do. The fact that no British statute, passed since, in terms confers this authority shows that this negative permission has been thought sufficient. This provision agrees very nearly in its fundamental elements with our own statute:

First. The letters are issued by the supreme executive.

Second. They are issued for a limited term.

Third. During the term so limited they confer the sole right.

Fourth. The manufacture must be new.

Fifth. The grant limited to the inventor.

Subsequently the British Parliament has revised, amended, and codified the patent laws of the Kingdom, but of these we have no present occasion to speak.

While the law of 1624 contains the limitation, "within this realm," yet it appears that patents were granted by the King to residents in the American colonies. Perhaps the word "realm" was given its broadest meaning to help out kingly desire. Sybella Masters, wife of Thomas Masters, of Philadelphia, seems to have been a woman of inventive turn. The King granted her three patents, one for curing corn, the other for weaving chip hats, and in 1717 her husband petitioned the lieutenant-governor of Pennsylvania for leave to record the same in Pennsylvania, and received the desired permission.

Some of the colonies also granted patents. In the statutes of Connecticut for the year 1672 is found, on page 52, the following provision:

> It is ordered that there shall be no monopolies granted or allowed amongst us but of such new inventions as shall be judged profitable to the country, and for such time as the general court shall deem fit.

Under this provision the colony granted several patents.

Massachusetts in 1641 granted to Samuel Winslow the sole right for ten years of making salt by his improved method.

After the close of the war of the Revolution, and before the adoption of the Federal Constitution, the several States granted patents. New Hampshire made several grants. The contest of Fitch and Rumsey before several of the State legislatures for exclusive grants for the propulsion of boats by steam are known to any student of the early history of our country. The Patent Office Report for 1850 gives a good many illustrations of this practice of the States.

Section 7 of the act of Congress approved February 21, 1793, provides:

> That where any State before its adoption of the present form of government shall have granted an exclusive right to any inventor, invention, etc.

It will be seen that when the framers of the new Constitution came to deal with this matter they had no new subject in hand. The granting for a limited term to an inventor of some new and useful machine the sole right to make, use, and vend such invention was a practice then nearly two centuries old, and one which, in this country, had existed for a century and a half.

In the light of that experience they provided (see Art. I, Sec. 8, Constitution United States):

> The Congress shall have power * * * to promote the progress of science and the useful arts, by securing, for limited times, to authors and inventors the exclusive right to their respective writings and discoveries; * * * to make all laws which shall be necessary and proper for carrying into execution the foregoing powers.

The object to be attained and the reason for the constitutional grant of power are imbedded in the grant itself. They are "to promote the progress of science and the useful arts." There is nothing said about any desire or purpose to secure to the author or inventor his "natural right to his property." The monopoly given him is avowedly given, not primarily for his benefit, but for the benefit of society at large. The claim made so often, especially of recent years, that the author or inventor has a natural right to the exclusive use of his production, and is therefore entitled, as of course, to legislation securing to him the full enjoyment of this right, does not seem to have been specifically passed upon by the fathers; but one thing is

absolutely certain, they did not make this constitutional grant of power upon any such ground. Much confusion of thought has arisen from the assertion of this right as an innate, absolute right existing in the individual, and a contemporaneous neglect to examine the limitation of the power given in the premises to Congress.

It is perhaps safe to say that for the past twenty or thirty years no Committee on Patents has had an existence which has not had the fortune to listen to long and very interesting arguments claiming the existence in the author or inventor of this right, and the duty of Congress to give by legislative enactment full and complete enjoyment of that right. Whatever may be the correct conclusion as to the existence of any such right, the duty of Congress is measured by its power, and that power can be no broader than the words conferring it.

It is unnecessary to call attention to the fact that a natural right is in its very nature and essence continuous and permanent, and that the words limiting the power to grant patents except "for limited times" seem to be entirely inconsistent with the nature and character of such right. It is sufficient to read the words of the grant in their plain every-day meaning to discover that the good of society was the only thing provided for, or intended to be provided for. If this legislation by Congress upon the subject of patents is authorized for this avowed purpose, and this purpose alone, it becomes the duty of the legislator to carfully ascertain whether this object has been attained in actual practice.

. . . . . .